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इस भाग में भिन्न पृष्ठ संख्या दी जाती है जिससे कि यह अलग संकलन के रूप में रखा जा सके।

Separate paging is given to this Part in order that it may be filed as a separate compilation

LOK SABHA

The following Bill was introduced in Lok Sabha on the 21st September, 1965:—

BILL No. 62 OF 1965

A Bill to amend and consolidate the law relating to patents.

BE it enacted by Parliament in the Sixteenth Year of the Republic of India as follows:—

CHAPTER I

PRELIMINARY

1. (*1*) This Act may be called the Patents Act, 1965. Short title, extent and commencement.

(*2*) It extends to the whole of India.

(*3*) It shall come into force on such date as the Central Government may, by notification in the Official Gazette, appoint.

Definitions and interpretation.

2. (*1*) In this Act, unless the context otherwise requires,—

(*a*) "assignee" includes the legal representative of a deceased assignee, and references to the assignee of any person include references to the assignee of the legal representative or assignee of that person;

(*b*) "Controller" means the Controller General of Patents, Designs and Trade Marks referred to in section 73;

(*c*) "convention application" means an application for a patent made by virtue of section 135;

(*d*) "convention country" means a country notified as such under sub-section (*1*) of section 133;

(*e*) "district court" has the meaning assigned to that expression by the Code of Civil Procedure, 1908; 5 of 1908.

(*f*) "exclusive licence" means a licence from a patentee which confers on the licensee, or on the licensee and persons authorised by him, to the exclusion of all other persons (including the patentee), any right in respect of the patented invention, and "exclusive licensee" shall be construed accordingly;

(*g*) "food" means any substance intended for the use of, or capable of being used by, babies, invalids or convalescents as an article of food or drink, which the Central Government may, by notification in the Official Gazette, specify in this behalf;

(*h*) "Government undertaking" means any industrial undertaking carried on—

(*i*) by a department of the Government, or

(*ii*) by a corporation established by a Central, Provincial or State Act, which is owned or controlled by the Government, or

(*iii*) by a Government company as defined in section 617 of the Companies Act, 1956, 1 of 1956.

and includes the Council of Scientific and Industrial Research, any University established by law in India and any other institution for scientific or technical education which is financed wholly or for the major part by the Government;

(*i*) "High Court" means—

(*i*) in relation to the Union territory of Delhi and the Union territory of Himachal Pradesh, the High Court of Punjab;

(*ii*) in relation to the Union territory of Manipur and the Union territory of Tripura, the High Court of Assam;

(*iii*) in relation to the Union territory of the Andaman and Nicobar Islands, the High Court at Calcutta;

(*iv*) in relation to the Union territory of the Laccadive, Minicoy and Amindivi Islands, the High Court of Kerala;

(*v*) in relation to the Union territory of Goa, Daman and Diu and the Union territory of Dadra and Nagar Haveli, the High Court of Bombay;

(*vi*) in relation to the Union territory of Pondicherry, the High Court of Madras; and

(*vii*) in relation to any other State, the High Court for that State;

(*j*) "invention" means any new and useful—

(*i*) art, process, method or manner of manufacture;

(*ii*) machine, apparatus or other article; or

(*iii*) substance produced by manufacture,

and includes any new and useful improvement of any of them, and an alleged invention;

(*k*) "legal representative" means a person who in law represents the estate of a deceased person;

(*l*) "medicine or drug" includes—

(*i*) all medicines for internal or external use of human beings or animals,

(*ii*) all substances intended to be used for or in the diagnosis, treatment, mitigation or prevention of diseases in human beings or animals,

(*iii*) all substances intended to be used for or in the maintenance of public health, or the prevention or control of any epidemic disease among human beings or animals,

(*iv*) all chemical substances, to the extent to which they are used as intermediates in the preparation or manufacture of any of the medicines or substances above referred to,

but does not include insecticide, germicide, fungicide or any other substance intended to be used for the protection or preservation of plants;

(*m*) "patent" means a patent granted under this Act;

(*n*) "patented article" and "patented process" mean respectively an article or process in respect of which a patent is in force;

(*o*) "patentee" means the person for the time being entered on the register as the grantee or proprietor of the patent;

(*p*) "patent agent" means a person for the time being registered under this Act as a patent agent;

(*q*) "patent of addition" means a patent granted in accordance with section 54;

(*r*) "patent office" means the patent office established under section 74;

(*s*) "person" includes the Government;

(*t*) "person interested" includes a person engaged in, or in promoting, research in the same field as that to which the invention relates;

(*u*) "prescribed" means, in relation to proceedings before a High Court, prescribed by rules made by the High Court, and in other cases, prescribed by rules made under this Act;

(*v*) "prescribed manner" includes the payment of the prescribed fee;

(*w*) "priority date" has the meaning assigned to it by section 11;

(*x*) "register" means the register of patents referred to in section 67;

(*y*) "true and first inventor" does not include either the first importer of an invention into India, or a person to whom an invention is first communicated from outside India.

(*2*) In this Act, unless the context otherwise requires, any reference—

(*a*) to the Controller shall be construed as including a reference to any officer discharging the functions of the Controller in pursuance of sub-section (*2*) of section 73;

(*b*) to the patent office shall be construed as including a reference to any branch office of the patent office.

CHAPTER II

INVENTIONS NOT PATENTABLE

What are not inventions.

3. The following are not inventions within the meaning of this Act—

(*a*) an invention which is frivolous or which claims anything obviously contrary to well established natural laws;

(*b*) an invention the primary or intended use of which would be contrary to law or morality or injurious to public health;

(c) the mere discovery of a scientific principle or the formulation of an abstract theory;

(*d*) the mere discovery of any new property or new use for a known substance or of the mere new use of a known process, machine or apparatus;

(*e*) a claim to a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance;

(*f*) the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;

(*g*) a method or process of testing applicable during the process of manufacture for rendering the machine, apparatus or other equipment more efficient or for the improvement or restoration of the existing machine, apparatus or other equipment or for the improvement or control of manufacture;

(*h*) a method of agriculture or horticulture;

(*i*) any process for the medicinal, surgical, curative, prophylactic or other treatment of man or any process for a similar treatment of animals or plants to render them free of disease or to increase their economic value or that of their products.

Inventions relating to atomic energy not patentable.

4. No patent shall be granted in respect of an invention relating to atomic energy falling within sub-section (*1*) of section 20 of the Atomic Energy Act, 1962.

33 of 1962.

Inventions where substances are not patentable but methods or processes may be.

5. In the case of inventions—

(*a*) claiming substances intended for use, or capable of being used, as food or as medicine or drug, or

(*b*) relating to substances prepared or produced by chemical processes (including alloys, optical glass, semi-conductors and inter-metallic compounds),

no patent shall be granted in respect of claims for the substances themselves, but claims for the methods or processes of manufacture shall be patentable.

CHAPTER III

APPLICATIONS FOR PATENTS

Persons entitled to apply for patents.

6. (*1*) Subject to the provisions contained in section 134, an application for a patent for an invention may be made by any of the following persons, that is to say,—

(*a*) by any person claiming to be the true and first inventor of the invention;

(*b*) by any person being the assignee of the person claiming to be the true and first inventor in respect of the right to make such an application;

(*c*) by the legal representative of any deceased person who immediately before his death was entitled to make such an application.

(*2*) An application under sub-section (*1*) may be made by any of the persons referred to therein either alone or jointly with any other person.

Form of application.

7. (*1*) Every application for a patent shall be for one invention only and shall be made in the prescribed form and filed in the patent office.

(*2*) Where the application is made by virtue of an assignment of the right to apply for a patent for the invention, there shall be furnished with the application or within such period as may be prescribed after the filing of the application—

(*a*) an affidavit by the person claiming to be the true and first inventor or his legal representative stating that he assents to the making of the application; and

(*b*) an affidavit signed by the applicant setting out the facts relied on to support the application.

(*3*) Every application under this section shall state that the applicant is in possession of the invention and shall name the owner

claiming to be the true and first inventor; and where the person so claiming is not the applicant or one of the applicants, the application shall contain a declaration that the applicant believes the person so named to be the true and first inventor.

(4) Every such application shall be accompanied by a provisional or a complete specification.

Information and undertaking regarding foreign applications.

8. (1) Where an applicant for a patent under this Act is prosecuting either alone or jointly with any other person an application for a patent in any country outside India in respect of the same or substantially the same invention, or where to his knowledge such an application is being prosecuted by some person through whom he claims or by some person deriving title from him, he shall file along with his application—

(a) a statement setting out the name of the country where the application is being prosecuted, the serial number and date of filing of the application and such other particulars as may be prescribed; and

(b) an undertaking that, up to the date of the acceptance of his complete specification filed in India, he would keep the Controller informed in writing, from time to time, of details of the nature referred to in clause (a) in respect of every other application relating to the same or substantially the same invention, if any, filed in any country outside India subsequently to the filing of the statement referred to in the aforesaid clause, within eight weeks from the date of the matter coming to his knowledge.

(2) The Controller may also require the applicant to furnish, as far as may be available to the applicant, details relating to the objections, if any, taken to any such application as is referred to in sub-section (1) on the ground that the invention is lacking in novelty or patentability, the amendments effected in the specifications, the claims allowed in respect thereof and such other particulars as he may require.

Provisional and complete specifications.

9. (1) Where an application for a patent (not being a convention application) is accompanied by a provisional specification, a complete specification shall be filed within twelve months from the date of filing of the application, and if the complete specification is not so filed the application shall be deemed to be abandoned:

Provided that the complete specification may be filed at any time after twelve months but within fifteen months from the date aforesaid, if a request to that effect is made to the Controller and the prescribed fee is paid on or before the date on which the complete specification is filed.

(2) Where two or more applications in the name of the same applicant are accompanied by provisional specifications in respect of inventions which are cognate or of which one is a modification of another and the Controller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may allow one complete specification to be filed in respect of all such provisional specifications.

(3) Where an application for a patent (not being a Convention application) is accompanied by a specification purporting to be a complete specification, the Controller may, if the applicant so requests at any time before the acceptance of the application, direct that such specification shall be treated for the purposes of this Act as a provisional specification and proceed with the application accordingly.

(4) Where a complete specification has been filed in pursuance of an application for a patent accompanied by a provisional specification or by a specification treated by virtue of a direction under sub-section (3) as a provisional specification, the Controller may, if the applicant so requests at any time before the acceptance of the application, cancel the provisional specification and post-date the application to the date of filing of the complete specification.

Contents of specifications.

10. (1) Every specification, whether provisional or complete, shall describe the invention and shall begin with a title sufficiently indicating the subject-matter to which the invention relates.

(2) Subject to any rules that may be made in this behalf under this Act, drawings may, and shall, if the Controller so requires, be supplied for the purposes of any specification, whether complete or provisional; and any drawings so supplied shall, unless the Controller otherwise directs, be deemed to form part of the specification, and references in this Act to a specification shall be construed accordingly.

(3) If in any particular case the Controller considers that an application should be further supplemented by a model or sample of anything illustrating the invention or alleged to constitute an invention, such model or sample as he may require shall be furnished before the acceptance of the application, but such model or sample shall not be deemed to form part of the specification.

(4) Every complete specification shall—

(a) fully and particularly describe the invention and its operation or use and the method by which it is to be performed;

(b) disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and

(*c*) end with a claim or claims defining the scope of the invention for which protection is claimed.

(5) The claim or claims of a complete specification shall relate to a single invention, shall be clear and succinct and shall be fairly based on the matter disclosed in the specification.

(6) A declaration as to the inventorship of the invention shall, in such cases as may be prescribed, be furnished in the prescribed form with the complete specification or within such period as may be prescribed after the filing of that specification.

(7) Subject to the foregoing provisions of this section, a complete specification filed after a provisional specification may include claims in respect of developments of, or additions to, the invention which was described in the provisional specification, being developments or additions in respect of which the applicant would be entitled under the provisions of section 6 to make a separate application for a patent.

Priority dates of claims of a complete specification.

11. (*1*) There shall be a priority date for each claim of a complete specification.

(*2*) Each claim of a complete specification shall indicate the date which the applicant considers to be the priority date of that claim.

(*3*) Where a complete specification is filed in pursuance of a single application accompanied by—

(*a*) a provisional specification; or

(*b*) a specification which is treated by virtue of a direction under sub-section (*3*) of section 9 as a provisional specification;

and the claim is fairly based on the matter disclosed in the specification referred to in clause (*a*) or clause (*b*), the priority date of that claim shall be the date of the filing of the relevant specification.

(*4*) Where the complete specification is filed or proceeded with in pursuance of two or more applications accompanied by such specifications as are mentioned in sub-section (*3*) and the claim is fairly based on the matter disclosed—

(*a*) in one of those specifications, the priority date of that claim shall be the date of filing of the application accompanied by that specification;

(*b*) partly in one and partly in another, the priority date of that claim shall be the date of the filing of the application accompanied by the specification of the later date.

(5) Where the complete specification has been filed in pursuance of a further application made by virtue of sub-section (*1*) of section 16 and the claim is fairly based on the matter disclosed in any of the earlier specifications, provisional or complete, as the case may be, the priority date of that claim shall be the date of the filing of that specification in which the matter was first disclosed.

(*6*) Where, under the foregoing provisions of this section, any claim of a complete specification would, but for the provisions of this sub-section, have two or more priority dates, the priority date of that claim shall be the earlier or earliest of those dates.

(*7*) In any case to which sub-sections (*3*), (*4*), (*5*) and (*6*) do not apply, the priority date of a claim shall, subject to the provisions of section 137, be the date of filing of the complete specification.

(*8*) The reference to the date of the filing of the application or of the complete specification in this section shall in cases where there has been a post-dating under sub-section (*2*) or sub-section (*3*) of section 16, be a reference to the date as so post-dated.

(*9*) A claim in a complete specification of a patent shall not be invalid by reason only of—

(*a*) the publication or use of the invention so far as claimed in that claim on or after the priority date of such claim; or

(*b*) the grant of another patent which claims the invention, so far as claimed in the first mentioned claim, in a claim of the same or a later priority date.

CHAPTER IV

EXAMINATION OF APPLICATIONS

Examination of applications.

12. When the complete specification has been filed in respect of an application for a patent, the application and the specification relating thereto shall be referred by the Controller to an examiner for making a report to him in respect of the following matters, namely:—

(*a*) whether the application and the specification relating thereto are in accordance with the requirements of this Act and of any rules made thereunder;

(*b*) whether there is any lawful ground of objection to the grant of the patent under this Act in pursuance of the application;

(c) the result of investigations made under section 13;

(d) whether the priority date of each claim as indicated by the applicant is the priority date of that claim as determined by this Act; and

(e) any other matter which may be prescribed.

Search for anticipation by previous publication and by prior claim.

13. (1) The examiner to whom an application for a patent is referred under section 12 shall make investigation for the purpose of ascertaining whether the invention so far as claimed in any claim of the complete specification—

(a) has been anticipated by publication before the date of filing of the applicant's complete specification in any specification filed in pursuance of an application for a patent made in India and dated on or after the 1st day of January, 1912;

(b) is claimed in any claim or any other complete specification published on or after the date of filing of the applicant's complete specification, being a specification filed in pursuance of an application for a patent made in India and dated before or claiming the priority date earlier than that date.

(2) The examiner shall, in addition, make such investigation as the Controller may direct for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, has been anticipated by publication in India or elsewhere in any document other than those mentioned in sub-section (1) before the date of filing of the applicant's complete specification.

(3) Where a complete specification is amended under the provisions of this Act before it has been accepted, the amended specification shall be examined and investigated in like manner as the original specification.

(4) The examination and investigations required under section 12 and this section shall not be deemed in any way to warrant the validity of any patent, and no liability shall be incurred by the Central Government or any officer thereof by reason of, or in connection with, any such examination or investigation or any report or other proceedings consequent thereon.

Consideration of report of examiner by controller.

14. Where, in respect of an application for a patent, the report of the examiner received by the Controller is adverse to the applicant or requires any amendment of the application or of the specification to ensure compliance with the provisions of this Act or of the rules made thereunder, the Controller, before proceeding to dispose of the

application in accordance with the provisions hereinafter appearing, shall communicate the gist of the objections to the applicant and shall, if so required by the applicant within the prescribed time, give him an opportunity of being heard.

Power of Controller to refuse or require amended applications in certain cases.

15. (*1*) Where the Controller is satisfied that the application or any specification filed in pursuance thereof does not comply with the requirements of this Act or of any rules made thereunder, the Controller may either—

(*a*) refuse to proceed with the application; or

(*b*) require the application, specification or drawings to be amended to his satisfaction before he proceeds with the application.

(*2*) If it appears to the Controller that—

(*a*) the application claiming to be a convention application was filed in contravention of the provisions of Chapter XXII; or

(*b*) the invention claimed in the specification is not an invention within the meaning of, or is not patentable under, this Act;

he shall refuse the application.

(*3*) If it appears to the Controller that any invention in respect of which an application for a patent is made might be used in any manner contrary to law, he may refuse the application, unless the specification is amended by the insertion of such dis-claimer in respect of that use of the invention, or such other reference to the illegality thereof, as the Controller thinks fit.

Power of Controller to make orders respecting division of application.

16. (*1*) A person who has made an application for a patent under this Act may, at any time before the acceptance of the complete specification, if he so desires, or with a view to remedy the objection raised by the Controller on the ground that the claims of the complete specification relate to more than one invention, file a further application in respect of an invention disclosed in the provisional or complete specification already filed in respect of the first mentioned application.

(*2*) The further application under sub-section (*1*) shall be accompanied by a complete specification, but such complete specification shall not include any matter not in substance disclosed in the complete specification filed in pursuance of the first mentioned application.

(3) The Controller may require such amendment of the complete specification filed in pursuance of either the original or the further application as may be necessary to ensure that neither of the said complete specifications includes a claim for any matter claimed in the other.

Explanation.—For the purposes of this Act, the further application and the complete specification accompanying it shall be deemed to have been filed on the date on which the complete specification in pursuance of the first mentioned application had been filed, and the further application shall, subject to the determination of the priority date under sub-section (5) of section 11, be proceeded with as a substantive application.

Power of Controller to make orders respecting dating of application.

17. (1) Subject to the provisions of section 9, at any time after the filing of an application and before acceptance of the complete specification under this Act, the Controller may, at the request of the applicant made in the prescribed manner, direct that the application shall be post-dated to such date as may be specified in the request, and proceed with the application accordingly:

Provided that no application shall be post-dated under this sub-section to a date later than six months from the date on which it was actually made or would, but for the provisions of this sub-section, be deemed to have been made.

(2) Where an application or specification (including drawings) is amended in pursuance of the directions of the Controller under sub-section (1) of section 15, the application or specification shall, if the Controller so directs, be deemed to have been made on the date on which the requirement is complied with or where the application or specification is returned to the applicant, on the date on which it is re-filed after complying with the requirement.

Powers of Controller in cases of anticipation.

18. (1) Where it appears to the Controller that the invention so far as claimed in any claim of the complete specification has been anticipated in the manner referred to in clause (*a*) of sub-section (1) or sub-section (2) of section 13, he may refuse to accept the complete specification unless the applicant—

(*a*) shows to the satisfaction of the Controller that the priority date of the claim of his complete specification is not later than the date on which the relevant document was published; or

(*b*) amends his complete specification to the satisfaction of the Controller.

(2) If it appears to the Controller that the invention is claimed in a claim of any other complete specification referred to in clause (b) of sub-section (1) of section 13, he may, subject to the provisions hereinafter contained, direct that a reference to that other specification shall be inserted by way of notice to the public in the applicant's complete specification unless within such time as may be prescribed,—

(a) the applicant shows to the satisfaction of the Controller that the priority date of his claim is not later than the priority date of the claim of the said other specification; or

(b) the complete specification is amended to the satisfaction of the Controller.

(3) If it appears to the Controller, as a result of an investigation under section 13 or otherwise,—

(a) that the invention so far as claimed in any claim of the applicant's complete specification has been claimed in any other complete specification referred to in clause (a) of sub-section (1) of section 13; and

(b) that such other complete specification was published on or after the priority date of the applicant's claim;

then, unless it is shown to the satisfaction of the Controller that the priority date of the applicant's claim is not later than the priority date of the claim of that specification, the provisions of sub-section (2) shall apply thereto in the same manner as they apply to a specification published on or after the date of filing of the applicant's complete specification.

(4) Any order of the Controller under sub-section (2) or sub-section (3) directing the insertion of a reference to another complete specification shall be of no effect unless and until the other patent is granted.

Powers of Controller in case of potential infringement.

19. (1) If, in consequence of the investigations required by the foregoing provisions of this Act or of proceedings under section 25, it appears to the Controller that an invention in respect of which an application for a patent has been made cannot be performed without substantial risk of infringement of a claim of any other patent, he may direct that a reference to that other patent shall be inserted in

the applicant's complete specification by way of notice to the public, unless within such time as may be prescribed—

(a) the applicant shows to the satisfaction of the Controller that there are reasonable grounds for contesting the validity of the said claim of the other patent; or

(b) the complete specification is amended to the satisfaction of the Controller.

(2) Where, after a reference to another patent has been inserted in a complete specification in pursuance of a direction under sub-section (1)—

(a) that other patent is revoked or otherwise ceases to be in force; or

(b) the specification of that other patent is amended by the deletion of the relevant claim; or

(c) it is found, in proceedings before the court or the Controller, that the relevant claim of that other patent is invalid or is not infringed by any working of the applicant's invention;

the Controller may, on the application of the applicant, delete the reference to that other patent.

Powers of Controller to make orders regarding substitution of applicants, etc.

20. (1) If the Controller is satisfied, on a claim made in the prescribed manner at any time before a patent has been granted, that by virtue of any assignment or agreement in writing made by the applicant or one of the applicants for the patent or by operation of law, the claimant would, if the patent were then granted, be entitled thereto or to the interest of the applicant therein, or to an undivided share of the patent or of that interest, the Controller may, subject to the provisions of this section, direct that the application shall proceed in the name of the claimant or in the names of the claimants and the applicant or the other joint applicant or applicants, accordingly as the case may require.

(2) No such direction as aforesaid shall be given by virtue of any assignment or agreement made by one of two or more joint applicants for a patent except with the consent of the other joint applicant or applicants.

(3) No such direction as aforesaid shall be given by virtue of any assignment or agreement for the assignment of the benefit of an invention unless—

(a) the invention is identified therein by reference to the number of the application for the patent; or

(*b*) there is produced to the Controller an acknowledgment by the person by whom the assignment or agreement was made that the assignment or agreement relates to the invention in respect of which that application is made; or

(*c*) the rights of the claimant in respect of the invention have been finally established by the decision of a court; or

(*d*) the Controller gives directions for enabling the application to proceed or for regulating the manner in which it should be proceeded with under sub-section (5).

(*4*) Where one of two or more joint applicants for a patent dies at any time before the patent has been granted, the Controller may, upon a request in that behalf made by the survivor or survivors, and with the consent of the legal representative of the deceased, direct that the application shall proceed in the name of the survivor or survivors alone.

(5) If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the Controller may, upon application made to him in the prescribed manner by any of the parties, and after giving to all parties concerned an opportunity to be heard, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it should be proceeded with, or for both those purposes, as the case may require.

Time for putting application in order for acceptance.

21. (*1*) An application for a patent shall be deemed to have been abandoned unless within fifteen months from the date on which the first statement of objections to the application or complete specification is forwarded by the Controller to the applicant or within such longer period as may be allowed under the following provisions of this section the applicant has complied with all the requirements imposed on him by or under this Act, whether in connection with the complete specification or otherwise in relation to the application.

Explanation.—Where the application or any specification or, in the case of a convention application, any document filed as part of the application has been returned to the applicant by the Controller in the course of the proceedings, the applicant shall not be deemed to have complied with such requirements unless and until he has re-filed it.

(2) The period allowed by sub-section (1) shall be extended by the Controller to such period not exceeding eighteen months from the date on which the objections referred to in sub-section (1) are forwarded to the applicant, if the applicant makes an application in this behalf in the prescribed manner before the expiration of the period so specified.

(3) If, at the expiration of the period allowed under the foregoing provisions of this section, an appeal to the High Court is pending in respect of the application (or, in the case of an application for a patent of addition, either in respect of that application or in respect of the application for the patent for the main invention) or the prescribed time within which such an appeal could be filed in the High Court (apart from any future extension of time granted by the Court for filing the appeal) has not expired, then—

(a) where such appeal is pending, or is brought within the aforesaid period of fifteen or eighteen months, as the case may be, or before the expiration of any extension of that time granted by the High Court (in the case of a first extension) on an application made within that time or (in the case of a subsequent extension) on an application made before the expiration of the last previous extension, the said period of fifteen or eighteen months, as the case may be, for complying with the requirements of the Controller shall be extended until such date as the High Court may determine;

(b) where no such appeal is pending or is so brought, the said period of fifteen or eighteen months, as the case may be, for complying with the requirements of the Controller shall continue until the end of the time aforesaid or, if any extension of that time is granted by the High Court as aforesaid, until the expiration of the extension or last extension so granted.

Acceptance of complete specification.

22. Subject to the provisions of section 21, the complete specification filed in pursuance of an application for a patent may be accepted by the Controller at any time after the applicant has complied with the requirements mentioned in sub-section (1) of that section, and, if not so accepted within the period allowed under that section for compliance with those requirements, shall be accepted as soon as may be thereafter:

Provided that the applicant may make an application to the Controller in the prescribed manner requesting him to postpone acceptance until such date (not being later than eighteen months from

the date on which the objections referred to in sub-section (2) of section 21 are forwarded to the applicant) as may be specified in the application, and, if such application is made, the Controller may postpone acceptance accordingly.

Advertisement of acceptance of complete specification.

23. On the acceptance of a complete specification, the Controller shall give notice thereof to the applicant and shall advertise in the Official Gazette the fact that the specification has been accepted, and thereupon the application and the specification with the drawings (if any) filed in pursuance thereof shall be open to public inspection.

Effect of acceptance of complete specification.

24. On and from the date of advertisement of the acceptance of a complete specification and until the date of sealing of a patent in respect thereof, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of advertisement of acceptance of the complete specification:

Provided that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been sealed.

CHAPTER V

OPPOSITION TO GRANT OF PATENT

Opposition to grant of patent.

25. (1) At any time within four months from the date of advertisement of the acceptance of a complete specification under this Act (or within such further period not exceeding one month in the aggregate as the Controller may allow on application made to him in the prescribed manner before the expiry of the four months aforesaid) any person interested may give notice to the Controller of opposition to the grant of the patent on any of the following grounds, namely:—

(a) that the applicant for the patent or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person of whom he is the legal representative;

(b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date claimed—

(i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or

(ii) in India or elsewhere, in any other document, not being a document of the class described in sub-section (2) or sub-section (3) of section 29;

(c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete speci-

fication published on or after the priority date of the applicant's claim and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the applicant's claim;

(*d*) that the invention so far as claimed in any claim of the complete specification was used in India before the priority date of that claim.

Explanation.—For the purposes of this clause, an invention relating to a process for which a patent is claimed shall be deemed to have been used in India before the priority date of the claim if a product made by that process had already been imported into India before that date;

(*e*) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (*b*) or having regard to what was used in India before the priority date of the applicant's claim;

(*f*) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;

(*g*) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

(*h*) that the applicant has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge;

(*i*) that in the case of a convention application, the application was not made within twelve months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title;

but on no other ground

(2) Where any such notice of opposition is duly given, the Controller shall notify the applicant and shall give to the applicant and the opponent an opportunity to be heard before deciding the case.

(3) The grant of a patent shall not be refused on the ground stated in clause (*c*) of sub-section (*1*) if no patent has been granted in pursuance of the application mentioned in that clause; and for the purpose of any inquiry under clause (*d*) or clause (*e*) of that sub-section no account shall be taken of any secret use

In cases of "Obtaining" Controller may treat application as application of opponent.

26. (*1*) Where in any opposition proceeding under this Act—

(*a*) the Controller finds that the invention, so far as claimed in any claim of the complete specification, was obtained from the opponent in the manner set out in clause (*a*) of sub-section (*1*) of section 25 and refuses the application on that ground, he may, on request by such opponent made in the prescribed manner, direct that the application shall proceed in the name of the opponent as if the application and the specification had been filed by the opponent on the date on which they were actually filed;

(*b*) the Controller finds that a part of an invention described in the complete specification was so obtained from the opponent and passes an order requiring that the specification be amended by the exclusion of that part of the invention, the opponent may, subject to the provisions of sub-section (*2*), file an application in accordance with the provisions of this Act accompanied by a complete specification for the grant of a patent for the invention so excluded from the applicant's specification, and the Controller may treat such application and specification as having been filed, for the purposes of this Act relating to the priority dates of claims of the complete specification, on the date on which the corresponding document was or was deemed to have been filed by the earlier applicant, but for all other purposes the application of the opponent shall be proceeded with as an application for a patent under this Act.

(*2*) Where an opponent has, before the date of the order of the Controller requiring the amendment of a complete specification referred to in clause (*b*) of sub-section (*1*), filed an application for a patent for an invention which includes the whole or a part of the invention held to have been obtained from him and such application is pending, the Controller may treat such application and specification in so far as they relate to the invention held to have been obtained from him, as having been filed, for the purposes of this Act, relating to the priority dates of claims of the complete specification, on the date on which the corresponding document was or was deemed to have been filed by the earlier applicant, but for all other purposes the application of the opponent shall be proceeded with as an application for a patent under this Act.

Refusal of patent without opposition.

27. If at any time after the acceptance of the complete specification filed in pursuance of an application for a patent and before the grant of a patent thereon it comes to the notice of the Controller otherwise than in consequence of proceedings in opposition to the

grant under section 25, that the invention, so far as claimed in any claim of the complete specification, has been published in India or any other country before the priority date of the claim—

(*a*) in any specification filed in pursuance of an application for a patent made in India and dated on or after the 1st day of January, 1912;

(*b*) in any other document in India or elsewhere not being a document of the class described in sub-section (*2*) or sub-section (*3*) of section 29;

the Controller may refuse to grant the patent unless, within such time as may be prescribed, the complete specification is amended to his satisfaction.

Mention of inventor as such in patent.

28. (*1*) If the Controller is satisfied, upon a request or claim made in accordance with the provisions of this section,—

(*a*) that the person in respect of or by whom the request or claim is made is the inventor of an invention in respect of which application for a patent has been made, or of a substantial part of that invention; and

(*b*) that the application for the patent is a direct consequence of his being the inventor;

the Controller shall, subject to the provisions of this section, cause him to be mentioned as inventor in any patent granted in pursuance of the application in the complete specification and in the register of patents:

Provided that the mention of any person as inventor under this section shall not confer or derogate from any rights under the patent.

(*2*) A request that any person shall be mentioned as aforesaid may be made in the prescribed manner by the applicant for the patent or (where the person alleged to be the inventor is not the applicant or one of the applicants) by the applicant and that person.

(*3*) If any person [other than a person in respect of whom a request in relation to the application in question has been made under sub-section (*2*)] desires to be mentioned as aforesaid, he may make a claim in the prescribed manner in that behalf.

(*4*) A request or claim under the foregoing provisions of this section shall be made not later than two months after the date of advertisement of acceptance of the complete specification or within

such further period (not exceeding one month) as the Controller may, on an application made to him in that behalf before the expiration of the said period of two months and subject to the payment of the prescribed fee, allow.

(5) No request or claim under the foregoing provisions of this section shall be entertained if it appears to the Controller that the request or claim is based upon facts which, if proved in the case of an opposition under the provisions of clause (*a*) of sub-section (*1*) of section 25 by the person in respect of or by whom the request or claim is made, would have entitled him to relief under that section.

(6) Subject to the provisions of sub-section (5), where a claim is made under sub-section (*3*), the Controller shall give notice of the claim to every applicant for the patent (not being the claimant) and to any other person whom the Controller may consider to be interested; and before deciding upon any request or claim made under sub-section (*2*) or sub-section (*3*), the Controller shall, if required, hear the person in respect of or by whom the request or claim is made, and, in the case of a claim under sub-section (*3*), any person to whom notice of the claim has been given as aforesaid.

(7) Where any person has been mentioned as inventor in pursuance of this section, any other person who alleges that he ought not to have been so mentioned may at any time apply to the Controller for a certificate to that effect, and the Controller may, after hearing, if required, any person whom he may consider to be interested, issue such a certificate, and if he does so, he shall rectify the specification and the register accordingly.

CHAPTER VI

ANTICIPATION

Anticipation by previous publication.

29. (*1*) An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that the invention was published in a specification filed in pursuance of an application for a patent made in India and dated before the 1st day of January, 1912.

(*2*) Subject as hereinafter provided, an invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that the invention was published before the priority

date of the relevant claim of the specification, if the patentee or the applicant for the patent proves—

(*a*) that the matter published was obtained from him, or (where he is not himself the true and first inventor) from any person from whom he derives title, and was published without his consent or the consent of any such person; and

(*b*) where the patentee or the applicant for the patent or any person from whom he derives title learned of the publication before the date of the application for the patent, or, in the case of a convention application, before the date of the application for protection in a convention country, that the application or the application in the convention country, as the case may be, was made as soon as reasonably practicable thereafter:

Provided that this sub-section shall not apply if the invention was before the priority date of the claim commercially worked in India, otherwise than for the purpose of reasonable trial, either by the patentee or the applicant for the patent or any person from whom he derives title or by any other person with the consent of the patentee or the applicant for the patent or any person from whom he derives title.

(*3*) Where a complete specification is filed in pursuance of an application for a patent made by a person being the true and first inventor or deriving title from him, an invention claimed in that specification shall not be deemed to have been anticipated by reason only of any other application for a patent in respect of the same invention made in contravention of the rights of that person, or by reason only that after the date of filing of that other application the invention was used or published, without the consent of that person, by the applicant in respect of that other application, or by any other person in consequence of any disclosure of any invention by that applicant.

Anticipation by previous communication to Government.

30. An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of the communication of the invention to the Government or to any person authorised by the Government to investigate the invention or its merits, or of anything done, in consequence of such a communication, for the purpose of the investigation.

Anticipation by public display, etc.

31. An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of—

(*a*) the display of the invention with the consent of the true and first inventor at an industrial or other exhibition to which

the provisions of this section have been extended by the Central Government by notification in the Official Gazette, or the use thereof with his consent for the purpose of such an exhibition in the place where it is held; or

(*b*) the publication of any description of the invention in consequence of the display or use of the invention at any such exhibition as aforesaid; or

(*c*) the use of the invention, after it has been displayed or used at any such exhibition as aforesaid and during the period of the exhibition, by any person without the consent of the true and first inventor; or

(*d*) the description of the invention in a paper read by the true and first inventor before a learned society or published with his consent in the transactions of such a society;

if the application for the patent is made by the true and first inventor or a person deriving title from him not later than six months after the opening of the exhibition or the reading or publication of the paper, as the case may be.

Anticipation by public working.

32. An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that at any time within one year before the priority date of the relevant claim of the specification, the invention was publicly worked in India—

(*a*) by the patentee or applicant for the patent or any person from whom he derives title; or

(*b*) by any other person with the consent of the patentee or applicant for the patent or any person from whom he derives title;

if the working was effected for the purpose of reasonable trial only and if it was reasonably necessary, having regard to the nature of the invention, that the working for that purpose should be effected in public.

Anticipation by use and publication after provisional specification.

33. (*1*) Where a complete specification is filed or proceeded with in pursuance of an application which was accompanied by a provisional specification or where a complete specification filed along with an application is treated by virtue of a direction under sub-section (*3*) of section 9 as a provisional specification, then, notwithstanding anything contained in this Act, the Controller shall not refuse to grant the patent, and the patent shall not be revoked

or invalidated, by reason only that any matter described in the provisional specification or in the specification treated as aforesaid as a provisional specification was used in India or published in India or elsewhere at any time after the date of the filing of that specification.

(2) Where a complete specification is filed in pursuance of a convention application, then, notwithstanding anything contained in this Act, the Controller shall not refuse to grant the patent, and the patent shall not be revoked or invalidated, by reason only that any matter disclosed in any application for protection in a convention country upon which the convention application is founded was used in India or published in India or elsewhere at any time after the date of that application for protection.

No anticipation if circumstances are only as described in sections 29, 30, 31 and 32.

34. Notwithstanding anything contained in this Act, the Controller shall not refuse to accept a complete specification for a patent or to grant a patent, and a patent shall not be revoked or invalidated by reason only of any circumstances which, by virtue of section 29 or section 30 or section 31 or section 32, do not constitute an anticipation of the invention claimed in the specification.

CHAPTER VII

PROVISIONS FOR SECRECY OF CERTAIN INVENTIONS

Secrecy directions relating to inventions relevant for defence purposes.

35. (1) Where, in respect of an application made before or after the commencement of this Act for a patent, it appears to the Controller that the invention is one of a class notified to him by the Central Government as relevant for defence purposes, or, where otherwise the invention appears to him to be so relevant, he may give directions for prohibiting or restricting the publication of information with respect to the invention or the communication of such information to any person or class of persons specified in the directions.

(2) Where the Controller gives any such directions as are referred to in sub-section (1), he shall give notice of the application and of the directions to the Central Government, and the Central Government shall, upon receipt of such notice, consider whether the publication of the invention would be prejudicial to the defence of India, and if upon such consideration, it appears to it that the publication of the invention would not so prejudice, give notice to the Controller to that effect, who shall thereupon revoke the directions and notify the applicant accordingly.

(3) Without prejudice to the provisions contained in sub-section (1), where the Central Government is of opinion that an invention in respect of which the Controller has not given any directions under sub-section (1), is relevant for defence purposes, it may at any time before acceptance of the complete specification notify the Controller to that effect, and thereupon the provisions of that sub-section shall apply as if the invention were one of the class notified by the Central Government, and accordingly the Controller shall give notice to the Central Government of the directions issued by him.

Secrecy directions to be periodically reviewed.

36. The question whether an invention in respect of which directions have been given under section 35 continues to be relevant for defence purposes shall be re-considered by the Central Government within nine months from the date of the filing of the application for the patent, and once at least during every subsequent year, and if, on such re-consideration it appears to the Central Government that the publication of the invention would no longer be prejudicial to the defence of India it shall forthwith give notice to the Controller accordingly and the Controller shall thereupon revoke the directions previously given by him.

Consequences of secrecy directions.

37. (1) So long as any directions under section 35 are in force in respect of an application—

(a) the Controller shall not pass an order refusing to accept the same; and

(b) notwithstanding anything contained in this Act, no appeal shall lie from any order of the Controller passed in respect thereof:

Provided that the application may, subject to the directions, proceed up to the stage of the acceptance of the complete specification, but the acceptance shall not be advertised nor the specification published, and no patent shall be granted in pursuance of the application.

(2) Where a complete specification filed in pursuance of an application for a patent for an invention in respect of which directions have been given under section 35 is accepted during the continuance in force of the directions, then—

(a) if any use of the invention is made during the continuance in force of the directions by or on behalf of or to the order of the Government, the provisions of sections 100, 101 and 103

shall apply in relation to that use as if the patent had been granted for the invention; and

(*b*) if it appears to the Central Government that the applicant for the patent has suffered hardship by reason of the continuance in force of the directions, the Central Government may make to him such payment (if any) by way of solatium as appears to the Central Government to be reasonable having regard to the novelty and utility of the invention and the purpose for which it is designed, and to any other relevant circumstances.

(*3*) Where a patent is granted in pursuance of an application in respect of which directions have been given under section 35, no renewal fee shall be payable in respect of any period during which those directions were in force.

Revocation of secrecy directions and extension of time

38. When any direction given under section 35 is revoked by the Controller, then, notwithstanding any provision of this Act specifying the time within which any step should be taken or any act done in connection with an application for the patent, the Controller may, subject to such conditions, if any, as he thinks fit to impose, extend the time for doing anything required or authorised to be done by or under this Act in connection with the application, whether or not that time has previously expired

Residents not to apply for patents outside India without prior permission.

39. (*1*) No person resident in India shall, except under the authority of a written permit granted by or on behalf of the Controller, make or cause to be made any application outside India for the grant of a patent for an invention unless—

(*a*) an application for a patent for the same invention has been made in India, not less than eight weeks before the application outside India; and

(*b*) either no directions have been given under sub-section (*1*) of section 35 in relation to the application in India, or all such directions have been revoked.

(*2*) The Controller shall not grant written permission to any person to make any application outside India without the prior consent of the Central Government.

(*3*) This section shall not apply in relation to an invention for which an application for protection has first been filed in a country outside India by a person resident outside India.

Liability for contravention of section 35 or section 39.

40. Without prejudice to the provisions contained in Chapter XX, if in respect of an application for a patent any person contravenes any direction as to secrecy given by the Controller under section 35 or makes or causes to be made an application for the grant of a patent outside India in contravention of section 39, the application for patent under this Act shall be deemed to have been abandoned and the patent granted, if any, shall be liable to be revoked under section 64.

Finality of orders of Controller and Central Government.

41. All orders of the Controller giving directions as to secrecy as well as all orders of the Central Government under this Chapter shall be final and shall not be called in question in any court on any ground whatsoever.

Savings respecting disclosure to Government.

42. Nothing in this Act shall be held to prevent the disclosure by the Controller of information concerning an application for a patent or a specification filed in pursuance thereof to the Central Government or any department thereof, for the purpose of the application or specification being examined for considering whether an order under this section should be made, varied or revoked.

CHAPTER VIII

GRANT AND SEALING OF PATENTS AND RIGHTS CONFERRED THEREBY

Grant and sealing of patent.

43. (*1*) Where a complete specification in pursuance of an application for a patent has been accepted and either--

(*a*) the application has not been opposed under section 25 and the time for the filing of the opposition has expired; or

(*b*) the application has been opposed and the opposition has been finally decided in favour of the applicant; or

(*c*) the application has not been refused by the Controller by virtue of any power vested in him by this Act;

the patent shall, on request made by the applicant in the prescribed form, be granted to the applicant or, in the case of a joint application, to the applicants jointly, and the Controller shall cause the patent to be sealed with the seal of the patent office and the date on which the patent is sealed shall be entered in the register.

(*2*) Subject to the provisions of sub-section (*1*) and of the provisions of this Act with respect to patents of addition, a request under this section for the sealing of a patent shall be made not later than the expiration of a period of six months from the date of advertisement of the acceptance of the complete specification:

Provided that—

(*a*) where at the expiration of the said six months any proceeding in relation to the application for the patent is pending before the Controller or the High Court, the request may be made within the prescribed period after the final determination of that proceeding;

(*b*) where the applicant or one of the applicants has died before the expiration of the time within which under the provisions of this sub-section the request could otherwise be made, the said request may be made at any time within twelve months after the date of the death or at such later time as the Controller may allow.

(*3*) The period within which under sub-section (*2*) a request for the sealing of a patent may be made may, from time to time, be extended by the Controller to such longer period as may be specified in an application made to him in that behalf, if the application is made and the prescribed fee paid within that longer period:

Provided that the first mentioned period shall not be extended under this sub-section by more than three months or such shorter period as may be prescribed.

Explanation.—For the purposes of this section a proceeding shall be deemed to be pending so long as the time for any appeal therein (apart from any future extension of that time) has not expired, and a proceeding shall be deemed to be finally determined when the time for any appeal therein (apart from any such extension) has expired without the appeal being brought.

Amendment of patent granted to deceased applicant.

44. Where at any time after a patent has been sealed in pursuance of an application under this Act, the Controller is satisfied that the person to whom the patent was granted had died, or, in the case of a body corporate, had ceased to exist, before the patent was sealed, the Controller may amend the patent by substituting for the name of that person the name of the person to whom the patent ought to have been granted, and the patent shall have effect, and shall be deemed always to have had effect, accordingly.

Date of patent.

45. (*1*) Subject to the other provisions contained in this Act, every patent shall be dated as of the date on which the complete specification was filed.

(*2*) The date of every patent shall be entered in the register.

(3) Notwithstanding anything contained in this section, no proceeding shall be taken in respect of an infringement committed before the date of advertisement of the acceptance of the complete specification.

Form, extent and effect of patent.

46. (1) Every patent shall be in the prescribed form and shall have effect throughout India.

(2) A patent shall be granted for one invention only:

Provided that it shall not be competent for any person in a suit or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

Rights of patentees.

47. (1) Subject to the other provisions contained in this Act, a patent granted, whether before or after the commencement of this Act, shall confer upon the patentee—

(a) where the patent is for an article or substance, the exclusive right by himself, his agents or licensees to make, use, exercise, sell or distribute such article or substance in India;

(b) where a patent is for a process of manufacturing an article or substance, the exclusive right by himself, his agents or licensees to use or exercise the process in India and of using or selling in India articles or substances made by such process and of authorising others so to do.

(2) The rights conferred on the patentee by this section shall be exercisable only subject to the provisions of any other law for the time being in force.

Patent rights not infringed when used for certain purposes

48. Notwithstanding anything contained in this Act,—

(a) the importation by or on behalf of the Government of any patented machine, apparatus or other article for the purpose merely of its own use, or

(b) the importation by or on behalf of the Government of any patented medicine or drug for the purpose merely of its own use or for distribution in any dispensary, hospital or other medical institution maintained by or on behalf of the Government or any other dispensary, hospital or other medical institution which may be specified by the Central Government in this behalf by notification in the Official Gazette, or

(c) the making of a patented machine, apparatus or other article or the use of a patented process or the making of an article by the use of the patented process by or on behalf of the Government for the purpose merely of its own use or by persons on its behalf who may be specially authorised for the purpose, or

(*d*) the making or use of a patented machine or apparatus or other article or the use of a patented process or the use of an article made by the use of the patented process, machine or apparatus for the purpose merely of experiment or research, including the imparting of instructions to pupils.

shall not be deemed to constitute an infringement of the rights conferred on the patentee by this Act.

Patent rights not infringed when used on foreign vessels, etc., temporarily or accidentally in India.

49. (*1*) **Where a vessel or aircraft registered in a foreign country** or a land vehicle owned by a person ordinarily resident in such country comes into India (including the territorial waters thereof) temporarily or accidentally only, the rights conferred by a patent for an invention shall not be deemed to be infringed by the use of the invention—

(*a*) in the body of the vessel or in the machinery, tackle, apparatus or other accessories thereof, so far as the invention is used on board the vessel and for its actual needs only; or

(*b*) in the construction or working of the aircraft or land vehicle or of the accessories thereof;

as the case may be.

(*2*) This section shall not extend to vessels, aircraft or land vehicles owned by persons ordinarily resident in a foreign country the laws of which do not confer corresponding rights with respect to the use of inventions in vessels, aircraft or land vehicles owned by persons ordinarily resident in India while in the ports or within the territorial waters of that foreign country or otherwise within the jurisdiction of its courts.

Rights of co-owners of patents.

50. (*1*) Where a patent is granted to two or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to an equal undivided share in the patent.

(*2*) Subject to the provisions contained in this section and in section 51, where two or more persons are registered as grantee or proprietor of a patent, then, unless an agreement to the contrary is in force, each of those persons shall be entitled, by himself or his agents, to make, use, exercise and sell the patented invention for his own benefit without accounting to the other person or persons.

(*3*) Subject to the provisions contained in this section and in section 51 and to any agreement for the time being in force, a licence under a patent shall not be granted, and a share in a patent shall not be assigned, except with the consent of all persons, other than the licensor or assignor, who are registered as grantee or proprietor of the patent.

(4) Where a patented article is sold by one of two or more persons registered as grantee or proprietor of a patent, the purchaser and any person claiming through him shall be entitled to deal with the article in the same manner as if the article had been sold by a sole patentee.

(5) Subject to the provisions contained in this section, the rules of law applicable to the ownership and devolution of movable property generally shall apply in relation to patents; and nothing contained in sub-section (1) or sub-section (2) shall affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or their rights or obligations as such.

(6) Nothing in this section shall affect the rights of the assignees of a partial interest in a patent created before the commencement of this Act.

Power of Controller to give directions to co-owners.

51. (1) Where two or more persons are registered as grantee or proprietor of a patent, the Controller may, upon application made to him in the prescribed manner by any of those persons, give such directions in accordance with the application as to the sale or lease of the patent or any interest therein, the grant of licences under the patent, or the exercise of any right under section 50 in relation thereto, as he thinks fit.

(2) If any person registered as grantee or proprietor of a patent fails to evecute any instrument or to do any other thing required for the carrying out of any direction given under this section within fourteen days after being requested in writing so to do by any of the other persons so registered, the Controller may, upon application made to him in the prescribed manner by any such other person, give directions empowering any person to execute that instrument or to do that thing in the name and on behalf of the person in default.

(3) Before giving any directions in pursuance of an application under this section, the Controller shall give an opportunity to be heard—

(a) in the case of an application under sub-section (1), to the other person or persons registered as grantee or proprietor of the patent;

(b) in the case of an application under sub-section (2), to the person in default.

(4) No direction shall be given under this section so as to affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or of their rights or obligations as such, or which is inconsistent with the terms of any agreement between co-proprietors of the patent.

Grant of patent to true and first inventor where it has been obtained by another in fraud of him.

52. (1) Where a patent has been revoked on the ground that the patent was obtained wrongfully and in contravention of the rights of the petitioner or any person under or through whom he claims, or, where in a petition for revocation, the court, instead of revoking the patent, directs the complete specification to be amended by the exclusion of a claim or claims in consequence of a finding that the invention covered by such claim or claims had been obtained from the petitioner, the court may, by order passed in the same proceeding, permit the grant to the petitioner of the whole or such part of the invention which the court finds has been wrongfully obtained by the patentee, in lieu of the patent so revoked or is excluded by amendment.

(2) Where any such order is passed, the Controller shall, on request by the petitioner made in the prescribed manner grant to him—

(i) in cases where the court permits the whole of the patent to be granted, a new patent bearing the same date and number as the patent revoked;

(ii) in cases where the court permits a part only of the patent to be granted, a new patent for such part bearing the same date as the patent revoked and numbered in such manner as may be prescribed:

Provided that the Controller may as a condition of such grant require the petitioner to file a new and complete specification to the satisfaction of the Controller describing and claiming that part of the invention for which the patent is to be granted.

(3) No suit shall be brought for any infringement of a patent granted under this section committed before the actual date on which such patent was granted.

Term of patent.

53. (1) Subject to the provisions of this Act, the term of every patent granted after the commencement of this Act shall—

(a) in respect of an invention claiming the method or process of manufacture of a substance, where the substance is intended for use, or is capable of being used, as food or as a medicine or drug, be ten years from the date of the patent; and

(b) in respect of any other invention, be fourteen years from the date of the patent.

(2) Notwithstanding anything contained in the Patents and Designs Act, 1911, or in the patent granted thereunder, the term of every patent granted before the commencement of this Act in respect of an invention claiming a substance or the method or process of manufacture in respect thereof, where the substance is intended for use, or

2 of 1911.

is capable of being used, as food or as medicine or drug shall be ten years from the date of the patent:

Provided that where at the commencement of this Act any such patent is in force by reason of an extension granted under the Act aforesaid, the patent shall cease to have effect on the expiration of the period of such extension.

(3) A patent shall cease to have effect notwithstanding anything therein or in this Act on the expiration of the period prescribed for the payment of any renewal fee, if that fee is not paid within the prescribed period or within that period as extended under this section.

(4) The period prescribed for the payment of any renewal fee shall be extended to such period, not being more than three months longer than the prescribed period, as may be specified in a request made to the Controller if the request is made and the renewal fee and the prescribed additional fee paid before the expiration of the period so specified.

CHAPTER IX

PATENTS OF ADDITION

Patents of addition.

34. (1) Subject to the provisions contained in this section, where an application is made for a patent in respect of any improvement in or modification of an invention described or disclosed in the complete specification filed therefor (in this Act referred to as the 'main invention') and the applicant also applies or has applied for a patent for that invention or is the patentee in respect thereof, the Controller may, if the applicant so requests, grant the patent for the improvement or modification as a patent of addition.

(2) Subject to the provisions contained in this section, where an invention, being an improvement in or modification of another invention, is the subject of an independent patent and the patentee in respect of that patent is also the patentee in respect of the patent for the main invention, the Controller may, if the patentee so requests, by order, revoke the patent for the improvement or modification and grant to the patentee a patent of addition in respect thereof, bearing the same date as the date of the patent so revoked.

(3) A patent shall not be granted as a patent of addition unless the date of filing of the complete specification was the same as or later than the date of filing of the complete specification in respect of the main invention.

(4) A patent of addition shall not be sealed before the sealing of the patent for the main invention; and if the period within which, but for the provisions of this sub-section, a request for the sealing of a patent of addition could be made under section 43 expires before

the period within which a request for the sealing of the patent for the main invention may be so made, the request for the sealing of the patent of addition may be made at any time within the last mentioned period.

Term of patents of addition.

55. (*1*) A patent of addition shall be granted for a term equal to that of the patent for the main invention, or so much thereof as has not expired, and shall remain in force during that term or until the previous cesser of the patent for the main invention and no longer:

Provided that if the patent for the main invention is revoked under this Act, the court, or, as the case may be, the Controller, on request made to him by the patentee in the prescribed manner, may order that the patent of addition shall become an independent patent for the remainder of the term for the patent for the main invention and thereupon the patent shall continue in force as an independent patent accordingly.

(*2*) No renewal fees shall be payable in respect of a patent of addition, but, if any such patent becomes an independent patent under sub-section (*1*), the same fees shall thereafter be payable, upon the same dates, as if the patent had been originally granted as an independent patent.

Validity of patents of addition.

56. (*1*) The grant of a patent of addition shall not be refused, and a patent granted as a patent of addition shall not be revoked or invalidated, on the ground only that the invention claimed in the complete specification does not involve any inventive step having regard to any publication or use of—

(*a*) the main invention described in the complete specification relating thereto; or

(*b*) any improvement in or modification of the main invention described in the complete specification of a patent of addition to the patent for the main invention or of an application for such a patent of addition;

and the validity of a patent of addition shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

(*2*) For the removal of doubts it is hereby declared that in determining the novelty of the invention claimed in the complete specification filed in pursuance of an application for a patent of addition regard shall be had also to the complete specification in which the main invention is described.

CHAPTER X

AMENDMENT OF SPECIFICATIONS

Amendment of specification before Controller.

57. (*1*) Subject to the provisions of section 59, the Controller may, upon application made under this section in the prescribed manner by an applicant for a patent or by a patentee, allow the complete specification to be amended subject to such conditions, if any, as the Controller thinks fit:

Provided that the Controller shall not pass any order allowing or refusing an application to amend a specification under this section while any suit before a court for the infringement of the patent or any proceeding before the High Court for the revocation of the patent is pending, whether the suit or proceeding commenced before or after the filing of the application to amend.

(*2*) Every application for leave to amend a specification under this section shall state the nature of the proposed amendment, and shall give full particulars of the reasons for which the application is made.

(*3*) Every application for leave to amend a specification under this section made after the acceptance of the complete specification and the nature of the proposed amendment shall be advertised in the prescribed manner.

(*4*) Where an application is advertised under sub-section (*3*), any person interested may, within the prescribed period after the advertisement thereof, give notice to the Controller of opposition thereto; and where such a notice is given within the period aforesaid, the Controller shall notify the person by whom the application under this section is made and shall give to that person and to the opponent an opportunity to be heard before he decides the case.

(*5*) An amendment under this section of a complete specification may be, or include, an amendment of the priority date of a claim.

(*6*) The provisions of this section shall be without prejudice to the right of an applicant for a patent to amend his specification to comply with the directions of the Controller passed before the acceptance of the complete specification and in the course of proceedings in opposition to the grant of a patent.

Amendment of specification before High Court.

58. (*1*) In any proceeding before the High Court for the revocation of a patent, the High Court may, subject to the provisions contained in section 59, allow the patentee to amend his complete specification in such manner and subject to such terms as to costs, advertisement or otherwise, as the High Court may think fit, and if in any proceedings for revocation the High Court decides that the patent is invalid, it may allow the specification to be amended under this section instead of revoking the patent.

(2) Where an application for an order under this section is made to the High Court, the applicant shall give notice of the application to the Controller, and the Controller shall be entitled to appear and be heard, and shall appear if so directed by the High Court.

(3) Copies of all orders of the High Court allowing the patentee to amend the specification shall be transmitted by the High Court to the Controller who shall on receipt thereof cause an entry thereof and reference thereto to be made in the register.

Supplementary provisions as to amendment of specification.

59. (1) No amendment of a complete specification shall be made except by way of disclaimer, correction or explanation, and no amendment thereof shall be allowed, except for the purpose of correcting an obvious mistake, the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed in the specification before the amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

(2) Where after the date of advertisement of acceptance of a complete specification, any amendment of the specification is allowed by the Controller or by the High Court,—

(a) the amendment shall for all purposes be deemed to form part of the specification;

(b) the fact that the specification has been amended shall be advertised in the Official Gazette; and

(c) the right of the applicant or patentee to make amendment shall not be called in question except on the ground of fraud.

(3) In construing the specification as amended, reference may be made to the specification as originally accepted.

CHAPTER XI

RESTORATION OF LAPSED PATENTS

Applications for restoration of lapsed patents.

60. (1) Where a patent has ceased to have effect by reason of failure to pay any renewal fee within the prescribed period or within that period as extended under sub-section (3) of section 53, and the Controller is satisfied, upon application made within three years from the date on which the patent ceased to have effect, that the failure was unintentional and that no undue delay has occurred in the making or prosecution of the application, he shall, by order, restore the patent and any patent of addition specified in the application which has ceased to have effect on the cesser of that patent.

(2) An application under this section may be made by the person who was the patentee or by his legal representative, and where the patent was held by two or more persons jointly, the application may, with the leave of the Controller, be made by one or more of them without joining the others.

(3) An application under this section shall contain a statement, verified in the prescribed manner, fully setting out the circumstances which led to the failure to pay the prescribed fee, and the Controller may require from the applicant such further evidence as he may think necessary.

Procedure for disposal of applications for restoration of lapsed patents.

61. (1) If, after hearing the applicant under section 60 in cases where the applicant so desires or the Controller thinks fit, the Controller is satisfied that a *prima facie* case has been made out for an order under that section, he shall advertise the application in the prescribed manner; and within the prescribed period any person interested may give notice to the Controller of opposition thereto on either or both of the following grounds, that is to say,—

(a) that the failure to pay the renewal fee was not unintentional; or

(b) that there has been undue delay in the making of the application.

(2) If notice of opposition is given within the period aforesaid, the Controller shall notify the applicant, and shall give to him and to the opponent an opportunity to be heard before he decides the case.

(3) If no notice of opposition is given within the period aforesaid or if in the case of opposition, the decision of the Controller is in favour of the applicant, the Controller shall, upon payment of any unpaid renewal fee and such additional fee as may be prescribed, make the order in accordance with the application.

(4) The Controller may, if he thinks fit as a condition of restoring the patent, require that an entry shall be made in the register of any document or matter which, under the provisions of this Act, has to be entered in the register but which has not been so entered.

Rights of patentees of lapsed patents which have been restored.

62. (1) Where a patent is restored, the rights of the patentee shall be subject to such provisions as may be prescribed and to such other provisions as the Controller thinks fit to impose for the protection or compensation of persons who may have begun to avail themselves of, or have taken definite steps by contract or otherwise to avail themselves of, the patented invention between the date when the patent ceased to have effect and the date of the order restoring the patent under this Chapter.

(2) No suit or other proceeding shall be commenced or prosecuted in respect of an infringement of a patent committed between the date on which the patent ceased to have effect and the date of the order restoring the patent.

CHAPTER XII

SURRENDER AND REVOCATION OF PATENTS

Surrender of patents.

63. (1) A patentee may, at any time by giving notice in the prescribed manner to the Controller, offer to surrender his patent.

(2) Where such an offer is made, the Controller shall advertise the offer in the prescribed manner, and also notify every person other than the patentee whose name appears in the register as having an interest in the patent.

(3) Any person interested may, within the prescribed period after such advertisement, give notice to the Controller of opposition to the surrender, and where any such notice is given the Controller shall notify the patentee.

(4) If the Controller is satisfied after hearing the patentee and any opponent, if desirous of being heard, that the patent may properly be surrendered, he may accept the offer and, by order, revoke the patent.

Revocation of patents.

64. (1) Subject to the provisions contained in this Act, a patent, whether granted before or after the commencement of this Act, may, on the petition of any person interested or of the Central Government, be revoked by the High Court on any of the following grounds, that is to say—

(a) that the invention, so far as claimed in any claim of the complete specification, was claimed in a valid claim of earlier priority date contained in the complete specification of another patent granted in India;

(b) that the patent was granted on the application of a person not entitled under the provisions of this Act to apply therefor:

Provided that a patent in force at the commencement of this Act shall not be revoked on the ground that the applicant was the communicatee or the importer of the invention in India and therefore not entitled to make an application for the grant of a patent under this Act;

(c) that the patent was obtained wrongfully in contravention of the rights of the petitioner or any person under or through whom he claims;

(*d*) that the subject of any claim of the complete specification is not an invention within the meaning of this Act;

(*e*) that the invention so far as claimed in any claim of the complete specification is not new, having regard to what was known or used in India before the priority date of the claim or to what was published in India or elsewhere in any of the documents referred to in section 13;

(*f*) that the invention so far as claimed in any claim of the complete specification is obvious or does not involve any inventive step, having regard to what was known or used in India or what was published in India or elsewhere before the priority date of the claim;

(*g*) that the invention, so far as claimed in any claim of the complete specification, is not useful;

(*h*) that the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, that is to say, that the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves sufficient to enable a person in India possessing average skill in, and average knowledge of, the art to which the invention relates, to work the invention, or that it does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection;

(*i*) that the scope of any claim of the complete specification is not sufficiently and clearly defined or that any claim of the complete specification is not fairly based on the matter disclosed in the specification;

(*j*) that the patent was obtained on a false suggestion or representation;

(*k*) that the subject of any claim of the complete specification is not patentable under this Act;

(*l*) that the invention so far as claimed in any claim of the complete specification was secretly used in India, otherwise than as mentioned in sub-section (2), before the priority date of the claim;

(*m*) that the applicant for the patent has failed to disclose to the Controller the information required by section 8 or has furnished information which in material particulars was false to his knowledge;

(*n*) that the applicant contravened any direction for secrecy passed under section 35 or made an application for the grant of a patent outside India in contravention of section 39;

(*o*) that leave to amend the complete specification under section 57 or section 58 was obtained by fraud.

(*2*) For the purposes of clauses (*e*) and (*f*) of sub-section (*1*),—

(*a*) no account shall be taken of secret use; and

(*b*) where the patent is for a process or for a product as made by a process described or claimed, the importation into India, of the product made abroad by that process shall constitute knowledge or use in India of the invention on the date of the importation.

(*3*) For the purposes of clause (*l*) of sub-section (*1*), no account shall be taken of any use of the invention—

(*a*) for the purpose of reasonable trial or experiment only;

(*b*) by the Government or by any person authorised by the Government or by a Government undertaking, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention directly or indirectly to the Government or person authorised as aforesaid or to the Government undertaking; or

(*c*) by any other person, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention, and without the consent or acquiescence of the applicant or of any person from whom he derives title.

(*4*) Without prejudice to the provisions contained in sub-section (*1*), a patent may be revoked by the High Court on the petition of the Central Government, if the High Court is satisfied that the patentee has without reasonable cause failed to comply with the request of the Central Government to make, use or exercise the patented invention for the purposes of Government within the meaning of section 99 upon reasonable terms.

(*5*) A notice of any petition for revocation of a patent under this section shall be served on all persons appearing from the register to be proprietors of that patent or to have shares or interests therein and it shall not be necessary to serve a notice on any other person.

Revocation of patent or amendment of complete specification on directions from Central Government in cases relating to atomic energy.

65. (*1*) Where at any time after acceptance of a complete specification, the Central Government is satisfied that an application for a patent or a patent is for an invention relating to atomic energy for which no patent can be granted under sub-section (*1*) of section 20 of the Atomic Energy Act, 1962, it may direct the Controller to refuse to proceed further with the application or to revoke the patent, as the case may be, and thereupon the Controller, after giving notice to the applicant or, as the case may be, to the patentee and every other person whose name has been entered in the register as having an interest in the patent, and after giving them an opportunity of being heard, may refuse to proceed further with the application or may revoke the patent. 33 of 1962.

(*2*) In any proceedings under sub-section (*1*), the Controller may allow the applicant for the patent or the patentee to amend the complete specification in such manner as he considers necessary instead of refusing to proceed with the application or revoking the patent.

Revocation of patent in public interest.

66. Where the Central Government is of opinion that a patent or the mode in which it is exercised is mischievous to the State or generally prejudicial to the public, it may, after giving the patentee an opportunity to be heard, make a declaration to that effect in the Official Gazette and thereupon the patent shall be deemed to be revoked.

CHAPTER XIII

REGISTER OF PATENTS

Register of patents and particulars to be entered therein.

67. (*1*) There shall be kept at the patent office a register of patents, wherein shall be entered—

(*a*) the names and addresses of grantees of patents;

(*b*) notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents; and

(*c*) particulars of such other matters affecting the validity or proprietorship of patents as may be prescribed.

(*2*) No notice of any trust, whether express, implied or constructive, shall be entered in the register, and the Controller shall not be affected by any such notice.

(*3*) Subject to the superintendence and direction of the Central Government, the register shall be kept under the control and management of the Controller.

(*4*) For the removal of doubts, it is hereby declared that the register of patents existing at the commencement of this Act shall be incorporated in, and form part of, the register under this Act.

Assignments, etc. not to be valid unless in writing and registered.

68. An assignment of a patent or of a share in a patent, a mortgage, licence or the creation of any other interest in a patent shall not be valid unless the same were in writing and the agreement between the parties concerned is reduced to the form of a document embodying all the terms and conditions governing their rights and obligations and the application for registration of such document is filed in the prescribed manner with the Controller within three months, or within such further period not exceeding three months in the aggregate as the Controller on application made in the prescribed manner allows, from the execution thereof:

Provided that the document shall, when registered, have effect from the date of its execution.

Registration of assignments, transmissions, etc.

69. (*1*) Where any person becomes entitled by assignment, transmission or operation of law to a patent or to a share in a patent or becomes entitled as a mortgagee, licensee or otherwise to any other interest in a patent, he shall apply in writing in the prescribed manner to the Controller for the registration of his title or, as the case may be, of notice of his interest in the register.

(*2*) Without prejudice to the provisions of sub-section (*1*), an application for the registration of the title of any person becoming entitled by assignment to a patent or a share in a patent or becoming entitled by virtue of a mortgage, licence or other instrument to any other interest in a patent may be made in the prescribed manner by the assignor, mortgagor, licensor or other party to that instrument, as the case may be.

(*3*) Where an application is made under this section for the registration of the title of any person the Controller shall, upon proof of title to his satisfaction,—

(*a*) where that person is entitled to a patent or a share in a patent, register him in the register as proprietor or co-proprietor of the patent, and enter in the register particulars of the instrument or event by which he derives title; or

(*b*) where that person is entitled to any other interest in the patent, enter in the register notice of his interest, with particulars of the instrument, if any, creating it:

Provided that where the validity of the transaction or transmission or of the mortgage, licence or other transaction referred to in sub-section (*1*) is in dispute between the parties, the Controller may refuse to register the transmission, mortgage, licence or other transaction until the rights of the parties have been determined by a competent court.

(4) There shall be supplied to the Controller in the prescribed manner for being filed in the patent office copies of all agreements, licences and other documents affecting the title to any patent or any licence thereunder authenticated in the prescribed manner and also such other documents as may be prescribed relevant to the subject-matter:

Provided that in the case of licences granted under a patent, the Controller shall, if so requested by the patentee or licensee, take steps for securing that the terms of the licence are not disclosed to any person except under the order of a court.

(5) Except for the purposes of an application under sub-section (1) or of an application to rectify the register, a document in respect of which no entry has been made in the register under sub-section (3) shall not be admitted by the Controller or by any court as evidence of the title of any person to a patent or to a share or interest therein unless the Controller or the court, for reasons to be recorded in writing, otherwise directs.

Power of registered grantee or proprietor to deal with patent.

70. Subject to the provisions contained in this Act relating to co-ownership of patents and subject also to any rights vested in any other person of which notice is entered in the register, the person or persons registered as grantee or proprietor of a patent shall have power to assign, grant licences under, or otherwise deal with, the patent and to give effectual receipts for any consideration for any such assignment, licence or dealing:

Provided that any equities in respect of the patent may be enforced in like manner as in respect of any other movable property.

Rectification of register by High Court.

71. (1) The High Court may, on the application of any person aggrieved—

(a) by the absence or omission from the register of any entry; or

(b) by any entry made in the register without sufficient cause; or

(c) by any entry wrongly remaining on the register; or

(d) by any error or defect in any entry in the register;

make such order for the making, variation or deletion, of any entry therein as it may think fit.

(2) In any proceeding under this section the High Court may decide any question that may be necessary or expedient to decide in connection with the rectification of the register.

(3) Notice of any application to the High Court under this section shall be given in the prescribed manner to the Controller who shall

be entitled to appear and be heard on the application, and shall appear if so directed by the court.

(4) Any order of the High Court under this section rectifying the register shall direct that notice of the rectification shall be served upon the Controller in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.

Register to be open for inspection.

72. (1) Subject to the provisions contained in this Act and any rules made thereunder, the register shall at all convenient times be open to inspection by the public; and certified copies, sealed with the seal of the patent office, of any entry in the register shall be given to any person requiring them on payment of the prescribed fee.

(2) The register shall be *prima facie* evidence of any matters required or authorised by or under this Act to be entered therein.

CHAPTER XIV

PATENT OFFICE AND ESTABLISHMENT

Controller and other officers.

73. (1) The Controller General of Patents, Designs and Trade Marks appointed under sub-section (1) of section 4 of the Trade and Merchandise Marks Act, 1958, shall be the Controller of Patents for the purposes of this Act.

43 of 1958.

(2) The Central Government may appoint as many examiners and other officers and with such designations as it thinks fit for the purpose of discharging, under the superintendence and directions of the Controller, such functions of the Controller under this Act as it may from time to time authorise them to discharge.

Patent office and its branches.

74. (1) For the purpose of this Act there shall be established an office which shall be known as the patent office.

(2) **The head office of the patent office shall be at such place as the Central Government may specify, and for the purpose of facilitating the registration of patents there may be established, at such other places as the Central Government may think fit, branch offices of the patent office.**

(3) There shall be a seal of the patent office.

Restrictions on employees of patent office as to right or interest in patents.

75. All officers and employees of the patent office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by that office.

Officers and employees not to furnish information, etc.

76. An officer or employee in the patent office shall not, except when required or authorised by this Act or under a direction in writing of the Central Government or the Controller or by order of a court,—

(*a*) furnish information on a matter which is being or has been, dealt with under this Act or under the Indian Patents and Designs Act, 1911; or 2 of 1911

(*b*) prepare or assist in the preparation of a document required or permitted by or under this Act or under the Indian Patents and Designs Act, 1911, to be lodged in the patent office; or 2 of 1911

(*c*) conduct a search in the records of the patent office.

CHAPTER XV

POWERS OF CONTROLLER GENERALLY

Controller to have certain powers of a civil court.

77. (*1*) Subject to any rules made in this behalf, the Controller in any proceedings before him under this Act shall have the powers of a civil court while trying a suit under the Code of Civil Procedure, 1908, in respect of the following matters, namely:— 5 of 1908.

(*a*) summoning and enforcing the attendance of any person and examining him on oath;

(*b*) requiring the discovery and production of any document;

(*c*) receiving evidence on affidavits;

(*d*) issuing commissions for the examination of witnesses or documents;

(*e*) awarding costs;

(*f*) reviewing his own decision on application made in the prescribed manner;

(*g*) setting aside orders passed *ex parte*;

(*h*) any other matter which may be prescribed.

(*2*) Any order for costs awarded by the Controller in exercise of the powers conferred upon him under sub-section (*1*) shall be executable as a decree of a civil court.

Power of Controller to correct clerical errors, etc.

78. (*1*) Without prejudice to the provisions contained in sections 57 and 59 as regards amendment of complete specifications filed in pursuance of an application for a patent and subject to the provisions of section 44, the Controller may, in accordance with the

provisions of this section, correct any clerical error in any patent or in any specification or other document filed in pursuance of such application or in any application for a patent or any clerical error in any matter which is entered in the register.

(2) A correction may be made in pursuance of this section either upon a request in writing made by any person interested and accompanied by the prescribed fee, or without such a request.

(3) Where the Controller proposes to make any such correction as aforesaid otherwise than in pursuance of a request made under this section, he shall give notice of the proposal to the patentee or the applicant for the patent, as the case may be, and to any other person who appears to him to be concerned, and shall give them an opportunity to be heard before making the correction.

(4) Where a request is made under this section for the correction of any error in a patent or application for a patent or any document filed in pursuance of such an application, and it appears to the Controller that the correction would materially alter the meaning or scope of the document to which the request relates and ought not to be made without notice to persons affected thereby, he shall require notice of the nature of the proposed correction to be advertised in the prescribed manner.

(5) Within the prescribed time after any such advertisement as aforesaid any person interested may give notice to the Controller of opposition to the request, and, where such notice of opposition is given, the Controller shall give notice thereof to the person by whom the request was made, and shall give to him and to the opponent an opportunity to be heard before he decides the case.

Evidence how to be given and powers of Controller in respect thereof.

79. Subject to any rules made in this behalf, in any proceeding under this Act before the Controller evidence shall be given by affidavit in the absence of directions by the Controller to the contrary, but in any case in which the Controller thinks it right so to do, he may take oral evidence in lieu of, or in addition to, evidence by affidavit, or may allow any party to be cross-examined on the contents of his affidavit.

Exercise of discretionary powers by Controller.

80. Without prejudice to any provision contained in this Act requiring the Controller to hear any party to the proceedings thereunder or to give any such party an opportunity to be heard, the Controller shall give to any applicant for a patent, or for amendment of a specification (if within the prescribed time the applicant so requires) an opportunity to be heard before exercising adversely to the applicant any discretion vested in the Controller by or under this Act.

Disposal by Controller of applications for extension of time.

81. Where under the provisions of this Act or the rules made thereunder the Controller may extend the time for doing any act, nothing in this Act shall be deemed to require him to give notice to or hear the party interested in opposing the extension, nor shall any appeal lie from any order of the Controller granting such extension.

CHAPTER XVI

WORKING OF PATENTS, COMPULSORY LICENCES, LICENCES OF RIGHT AND REVOCATION

Definitions of "patented articles" and "patentee".

82. In this Chapter,—

(*a*) "patented article" includes any article made by a patented process; and

(*b*) "patentee" includes an exclusive licensee.

General principles applicable to working of patented inventions.

83. Without prejudice to the other provisions contained in this Act, in exercising the powers conferred by this Chapter, regard shall be had to the following general considerations, namely,—

(*a*) that patents are granted to encourage inventions and to secure that the inventions are worked in India on a commercial scale and to the fullest extent that is reasonably practicable without undue delay; and

(*b*) that they are not granted merely to enable patentees to enjoy a monopoly for the importation of the patented article.

Compulsory licences.

84. (*1*) At any time after the expiration of three years from the date of the sealing of a patent, any person interested may make an application to the Controller alleging that the reasonable requirements of the public with respect to the patented invention have not been satisfied and praying for the grant of a compulsory licence to work the patented invention.

(*2*) An application under this section may be made by any person notwithstanding that he is already the holder of a licence under the patent and no person shall be estopped from alleging that the reasonable requirements of the public with respect to the patented invention are not satisfied by reason of any admission made by him, whether in such a licence or otherwise or by reason of his having accepted such a licence.

(*3*) Every application under sub-section (*1*) shall contain a statement setting out the nature of the applicant's interest together with such particulars as may be prescribed and the facts upon which the application is based.

(4) In considering the application filed under this section the Controller shall take into account the matters set out in section 85.

(5) The Controller, if satisfied that the reasonable requirements of the public with respect to the patented invention have not been satisfied, may order the patentee to grant a licence upon such terms as he may deem fit.

(6) Where the Controller directs the patentee to grant a licence he may as incidental thereto exercise the powers set out in section 93.

(7) The decision of the Controller shall be subject to appeal to the Central Government.

Matters to be taken into account in granting compulsory licences.

85. In determining whether or not to make an order in pursuance of an application filed under section 84, the Controller shall take into account:—

(*i*) the nature of the invention, the time which has elapsed since the sealing of the patent and the measures already taken by the patentee or any licensee to make full use of the invention;

(*ii*) the ability of the applicant to work the invention to the public advantage;

(*iii*) where the invention relates to a scheduled industry within the meaning of the Industries (Development and Regulation) Act, 1951, whether the applicant would be granted permission to work the invention, if a licence were granted;

65 of 1951.

(*iv*) the capacity of the applicant to undertake the risk in providing capital and working the invention, if the application were granted;

but shall not be required to take into account matters subsequent to the making of the application.

Endorsement of patent with the words "Licences of right".

86. (*1*) At any time after the expiration of three years from the date of the sealing of a patent, the Central Government may make an application to the Controller for an order that the patent may be endorsed with the words "Licences of right" on the ground that the reasonable requirements of the public with respect to the patented invention have not been satisfied.

(2) The Controller, if satisfied that the reasonable requirements of the public with respect to the patented invention have not been satisfied, may make an order that the patent be endorsed with the words "Licences of right".

(3) Where a patent of addition is in force, any application made under this section for an endorsement either of the original patent or of the patent of addition shall be treated as an application for the

endorsement of both patents, and where a patent of addition is granted in respect of a patent which is already endorsed under this section, the patent of addition shall also be so endorsed.

(4) All endorsements of patents made under this section shall be entered in the register and published in the Official Gazette and in such other manner as the Controller thinks desirable for bringing the endorsement to the notice of manufacturers.

Certain patents deemed to be endorsed with the words "Licences of right".

87. (1) Notwithstanding anything contained in this Act,—

(a) every patent in force at the commencement of this Act in respect of inventions relating to—

(i) substances used or capable of being used as food or as medicine or drug;

(ii) the methods or processes for the manufacture or production of any such substance as is referred to in sub-clause (i);

(iii) the methods or processes for the manufacture or production of chemical substances (including alloys, optical glass, semi-conductors and inter-metallic compounds); and

(b) every patent granted after the commencement of this Act in respect of any such invention as is referred to in sub-clauses (ii) and (iii) of clause (a);

shall be deemed to be endorsed with the words "Licences of right", in the case of inventions referred to in clause (a), from the commencement of this Act, and, in the case of inventions referred to in clause (b), from the date of sealing of the patent.

(2) In respect of every patent which is deemed to be endorsed with the words "Licences of right" under this section, the provisions of section 88 shall apply.

Effect of endorsement of patent with the words "Licences of right".

88. (1) Where a patent has been endorsed with the words "Licences of right", any person who is interested in working the patented invention in India may require the patentee to grant him a licence for the purpose on such terms as may be mutually agreed upon.

(2) If the parties are unable to agree on the terms of the licence, either of them may apply in the prescribed manner to the Controller to settle the terms thereof.

(3) The Controller shall, after giving notice to the parties and hearing them and after making such enquiry as he may deem fit, decide the terms on which the licence shall be granted by the patentee,

(4) The Controller may at any time before the terms of the licence are mutually agreed upon or decided by the Controller, on application made to him in this behalf by any person who has made any such requisition as is referred to in sub-section (1), permit him to work the patented invention on such terms as the Controller may, pending agreement between the parties or decision by the Controller, think fit to impose.

(5) In respect of every patent deemed to be endorsed with the words "Licences of right" under sub-clause (*i*) or sub-clause (*ii*) of clause (*a*) of sub-section (1) of section 87, whether the patent was granted before or after the commencement of this Act, the royalty and other remuneration reserved to the patentee under a licence granted to any person after such commencement shall in no case exceed four per cent. of the net *ex*-factory sale price in bulk of the patented article (exclusive of taxes levied under any law for the time being in force and any commissions payable) determined in such manner as may be prescribed.

(6) Save as otherwise provided in sub-section (5), the provisions of sub-sections (1), (2), (4), (5) and (6) of section 93 (regarding the powers of the Controller) and of sections 94 and 95 shall apply to licences granted under this section as they apply to licences granted under section 84.

Revocation of patents by the Controller for non-working.

89. (1) Where, in respect of a patent, a compulsory licence has been granted or the endorsement "Licences of right" has been made or is deemed to have been made, the Central Government or any person interested may, after the expiration of two years from the date of the order granting the first compulsory licence or, as the case may be, the date of the endorsement, apply to the Controller for an order revoking the patent on the ground that the reasonable requirements of the public with respect to the patented invention have not been satisfied.

(2) Every application under sub-section (1) shall contain such particulars as may be prescribed and the facts upon which the application is based, and, in the case of an application other than by the Central Government, shall also set out the nature of the applicant's interest.

(3) The Controller, if satisfied that the reasonable requirements of the public with respect to the patented invention have not been satisfied, may make an order revoking the patent.

When reasonable requirements of the public deemed not satisfied.

90. For the purposes of sections 84, 86 and 89, the reasonable requirements of the public shall be deemed not to have been satisfied—

(*a*) if, by reason of the default of the patentee to manufacture in India to an adequate extent and supply on reasonable terms the patented article or a part of the patented article which is neces-

sary for its efficient working or if, by reason of the refusal of the patentee to grant a licence or licences on reasonable terms,—

(*i*) an existing trade or industry or the development thereof or the establishment of any new trade or industry in India or the trade or industry of any person or classes of persons trading or manufacturing in India is prejudiced; or

(*ii*) the demand for the patented article is not being met to an adequate extent or on reasonable terms from manufacture in India; or

(*iii*) a market for the export of the patented article manufactured in India is not being supplied or developed or such market capable of being created is not being created; or

(*iv*) the establishment or development of commercial activities in India is prejudiced; or

(*b*) if, by reason of conditions imposed by the patentee (whether before or after the commencement of this Act) upon the grant of licences under the patent, or upon the purchase, hire or use of the patented article or process, the manufacture, use or sale of materials not protected by the patent, or the establishment or development of any trade or industry in India, is prejudiced; or

(*c*) if the patented invention is not being worked in India on a commercial scale to an adequate extent or is not being so worked to the fullest extent that is reasonably practicable; or

(*d*) if the demand for the patented article in India is being met to a substantial extent by importation from abroad by—

(*i*) the patentee or persons claiming under him; or

(*ii*) persons directly or indirectly purchasing from him; or

(*iii*) other persons against whom the patentee is not taking or has not taken proceedings for infringement; or

(*e*) if the working of the patented invention in India on a commercial scale is being prevented or hindered by the importation from abroad of the patented article by the patentee or the other persons referred to in the preceding clause.

Power of Controller to adjourn applications for compulsory licences,

91. (*1*) Where an application under section 84, section 86 or section 89, as the case may be, is made on the ground mentioned in clause (*c*) of section 90 and the Controller is satisfied that the time which has elapsed since the sealing of the patent has for any reason been insufficient to enable the invention to be worked on a commercial scale to an adequate extent or to enable the invention to be so worked to the fullest extent that is reasonably practicable, he may, by

order, adjourn the further hearing of the application for such period not exceeding twelve months in the aggregate as appears to him to be sufficient for the invention to be so worked. etc., in certain cases.

(2) No adjournment under sub-section (1) shall be ordered unless the Controller is satisfied that the patentee has taken with promptitude adequate or reasonable steps to start the working of the invention in India on a commercial scale and to an adequate extent.

(3) In computing the period of twelve months referred to in sub-section (1) in any case where the patentee establishes that the reason why a patented invention could not be worked or worked on a commercial scale to an adequate extent or worked to the fullest extent that is reasonably practicable before the date of the application was due to any State or Central Act or any rule or regulation made thereunder or any order of the Government imposed otherwise than by way of a condition for the working of the invention in India or for the disposal of the patented articles or of the articles made by the process or by the use of the patented plant, machinery or apparatus, the period during which such Act, rule or regulation or order of Government preventing the working of the invention was in force shall be excluded.

92. (1) Where the Controller is satisfied, upon consideration of an application under section 84, section 86 or section 89, that a *prima facie* case has been made out for the making of an order, he shall direct the applicant to serve copies of the application upon the patentee and any other person appearing from the register to be interested in the patent in respect of which the application is made, and shall advertise the application in the Official Gazette. Procedure for dealing with applications under sections 84, 86 and 89.

(2) The patentee or any other person desiring to oppose the application may, within such time as may be prescribed or within such further time as the Controller may on application (made either before or after the expiration of the prescribed time) allow, give to the Controller notice of opposition.

(3) Any such notice of opposition shall contain a statement setting out the grounds on which the application is opposed.

(4) Where any such notice of opposition is duly given, the Controller shall notify the applicant, and shall give to the applicant and the opponent an opportunity to be heard before deciding the case.

93. (1) Where the Controller is satisfied on application made under section 84 that the manufacture, use or sale of materials not protected by the patent is prejudiced by reason of conditions imposed by the patentee upon the grant of licences under the patent, or upon Powers of Controller in granting compulsory licences.

the purchase, hire or use of the patented article or process, he may, subject to the provisions of that section, order the grant of licences under the patent to such customers of the applicant as he thinks fit as well as to the applicant.

(2) Where an application under section 84 is made by a person being the holder of a licence under the patent, the Controller may, if he makes an order for the grant of a licence to the applicant, order the existing licence to be cancelled, or may, if he thinks fit, instead of making an order for the grant of a licence to the applicant, order the existing licence to be amended.

(3) Where on an application made under section 84 the Controller orders the grant of a licence, he may direct that the licence shall operate—

(a) to deprive the patentee of any right which he may have as patentee to make, use, exercise or vend the invention or to grant licences under the patent;

(b) to revoke all existing licences in respect of the invention.

(4) Where two or more patents are held by the same patentee and an applicant for a compulsory licence establishes that the reasonable requirements of the public have not been satisfied with respect to some only of the said patents, then, if the Controller is satisfied that the applicant cannot efficiently or satisfactorily work the licence granted to him under those patents without infringing the other patents held by the patentee, he may, by order, direct the grant of a licence in respect of the other patents also to enable the licensee to work the patent or patents in regard to which a licence is granted under section 84.

(5) Where the terms and conditions of a licence have been settled by the Controller, an application may be made to the Controller by the licensee for the revision of the terms on the ground that the terms settled have proved to be more onerous than originally expected and that in consequence thereof the licensee is unable to work the invention except at a loss:

Provided that no such application shall be entertained,—

(a) unless the licensee has worked the invention on a commercial scale for a period of at least twelve months, or

(b) a second time.

(6) The decision of the Controller shall be subject to appeal to the Central Government.

General purposes for granting compulsory licences.

94. The powers of the Controller upon an application made under section 84 shall be exercised with a view to securing the following general purposes, that is to say,—

(*a*) that patented inventions are worked on a commercial scale in India without undue delay and to the fullest extent that is reasonably practicable;

(*b*) that the interests of any person for the time being working or developing an invention in India under the protection of a patent are not unfairly prejudiced.

Terms and conditions of compulsory licences.

95. (*1*) In settling the terms and conditions of a licence under section 84, the Controller shall endeavour to secure—

(*i*) that the royalty and other remuneration, if any, reserved to the patentee or other person beneficially entitled to the patent, is reasonable, having regard to the nature of the invention, the expenditure incurred by the patentee in making the invention or in developing it and obtaining a patent and keeping it in force and other relevant factors;

(*ii*) that the patented invention is worked to the fullest extent by the person to whom the licence is granted and with reasonable profit to him;

(*iii*) that the patented articles are made available to the public at reasonable prices.

(*2*) No licence granted by the Controller shall authorise the licensee to import the patented article or an article or substance made by a patented process from abroad where such importation would, but for such authorisation, constitute an infringement of the rights of the patentee.

(*3*) Notwithstanding anything contained in sub-section (*2*), the Central Government may, if in its opinion it is necessary so to do in the public interest, direct the Controller at any time to authorise any licensee in respect of a patent to import the patented article or an article or substance made by a patented process from abroad (subject to such conditions as it considers necessary to impose relating among other matters to the quantum of import, the sale price of the imported article, and the period of importation), and thereupon the Controller shall give effect to the directions.

Licensing of related patents.

96. (*1*) Notwithstanding anything contained in the other provisions of this Chapter, at any time after the sealing of a patent, any person who has the right to work any other patented invention either as patentee or as licensee thereof, exclusive or otherwise, may apply

to the Controller for the grant of a licence of the first mentioned patent on the ground that he is prevented or hindered without such licence from working the other invention efficiently or to the best advantage possible.

(2) No order under sub-section (1) shall be made unless the Controller is satisfied that the applicant is able and willing to grant, or procure the grant to the patentee and his licensees if they so desire of, a licence in respect of the other invention on reasonable terms.

(3) When the Controller is satisfied that the conditions mentioned in sub-section (1) have been established by the applicant, he may make an order on such terms as he thinks fit granting a licence under the first mentioned patent and a similar order under the other patent if so requested by the proprietor of the first mentioned patent or his licensee.

(4) The provisions of sections 92 and 110 shall apply to licences granted under this section as they apply to licences granted under section 84.

(5) The decision of the Controller shall be subject to appeal to the Central Government.

Special provision for compulsory licences on notification by Central Government.

97. (1) If the Central Government is satisfied in respect of any patent or class of patents in force that it is necessary or expedient in the public interest that compulsory licences should be granted at any time after the sealing thereof to work the invention or inventions, it may make a declaration to that effect in the Official Gazette, and thereupon the following provisions shall have effect, that is to say—

(i) the Controller shall on application made at any time after the notification by any person interested grant to the applicant a licence under the patent on such terms as he thinks fit;

(ii) in settling the terms of a licence granted under this section, the Controller shall endeavour to secure that the articles manufactured under the patent shall be available to the public at the lowest prices consistent with the patentees deriving a reasonable advantage from their patent rights.

(2) The provisions of sections 92, 93, 94 and 95 shall apply in relation to the grant of licences under this section as they apply in relation to the grant of licences under section 84.

(3) The decision of the Controller shall be subject to appeal to the Central Government.

98. Any order for the grant of a licence under this Chapter shall operate as if it were a deed granting a licence executed by the patentee and all other necessary parties embodying the terms and conditions, if any, settled by the Controller. Order for licence to operate as a deed between parties concerned.

CHAPTER XVII

USE OF INVENTIONS FOR PURPOSES OF GOVERNMENT AND ACQUISITION OF INVENTIONS BY CENTRAL GOVERNMENT

99. (*1*) For the purposes of this Chapter, an invention is said to be used for the purposes of Government if it is made, used, exercised or vended for the purposes of the Central Government, a State Government or a Government undertaking or any other undertaking in a class or classes of industries which the Central Government, having regard to the interests of the general public may notify in this behalf in the Official Gazette. Meaning of use of invention for purposes of Government.

(*2*) Nothing contained in this Chapter shall apply in the case of any such use of an invention as is deemed not to constitute an infringement of the patentee's rights under section 48 and under which no royalty or other remuneration is payable to the patentee.

100. (*1*) Notwithstanding anything contained in this Act, at any time after an application for a patent has been filed at the patent office or a patent has been granted, the Central Government and any person authorised in writing by it, may make, use, exercise or vend the invention for the purposes of Government in accordance with the provisions of this Chapter. Power of Central Government to use inventions for purposes of Government.

(*2*) Where an invention has, before the priority date of the relevant claim of the complete specification, been duly recorded in a document, or tested or tried, by or on behalf of the Government or a Government undertaking, otherwise than in consequence of the communication of the invention directly or indirectly by the patentee or by a person from whom he derives title, any use of the invention for the purposes of Government may be made free of any royalty or other remuneration to the patentee.

(*3*) If and so far as the invention has not been so recorded or tried or tested as aforesaid, any use of the invention made by the Central Government or any person authorised by it under sub-section (*1*), at any time after the acceptance of the complete specification in respect of the patent or in consequence of any such communication as aforesaid, shall be made upon terms as may be agreed upon either

before or after the use, between the Central Government or any person authorised under sub-section (*1*) and the patentee, or, as may in default of agreement be determined by the High Court on a reference under section 103.

(*4*) The authorisation by the Central Government in respect of an invention may be given under this section, either before or after the patent is granted and either before or after the acts in respect of which such authorisation is given or done, and may be given to any person, whether or not he is authorised directly or indirectly by the applicant or the patentee to make, use, exercise or vend the invention.

(*5*) Where an invention has been made, used, exercised or vended by or with the authority of the Central Government for the purposes of Government under this section, then, unless it appears to the Government that it would be contrary to the public interest so to do, the Government shall notify the patentee as soon as practicable after the use has begun and furnish him with such information as to the extent of the making, use, exercise or vending of the invention as he may, from time to time, reasonably require; and where the use of the invention has been for the purposes of a Government undertaking or an undertaking in a class or classes of industries notified by the Central Government under section 99, the Central Government may call for such information as may be necessary for this purpose from such undertaking.

(*6*) The right to make, use, exercise and vend an invention for the purposes of Government under sub-section (*1*) shall include the right to sell the goods which have been made in exercise of that right, and a purchaser of goods so sold, and a person claiming through him, shall have the power to deal with the goods as if the Central Government or the person authorised under sub-section (*1*) were the patentee of the invention.

(*7*) Where in respect of a patent which has been the subject of an authorisation under this section, there is an exclusive licensee as is referred to in sub-section (*3*) of section 101, or where such patent has been assigned to the patentee in consideration of royalties or other benefits determined by reference to the use of the invention (including payments by way of minimum royalty), the notice directed to be given under sub-section (5) shall also be given to such exclusive licensee or assignor as the case may be, and the reference to the patentee in sub-section (*3*) shall be deemed to include a reference to such assignor or exclusive licensee.

Rights of third parties in respect of use of invention for purposes of Government.

101. (*1*) In relation to any use of a patented invention, or an invention in respect of which an application for a patent is pending, made for the purposes of Government—

(*a*) by the Central Government or any person authorised by the Central Government under section 100; or

(*b*) by the patentee or applicant for the patent to the order made by the Central Government,

the provisions of any licence, assignment or agreement granted or made, whether before or after the commencement of this Act, between the patentee or applicant for the patent (or any person who derives title from him or from whom he derives title) and any person other than the Central Government shall be of no effect so far as those provisions—

(*i*) restrict or regulate the use for the purposes of Government of the invention, or of any model, document or information relating thereto, or

(*ii*) provide for the making of payments in respect of any use of the invention or of the model, document or information relating thereto for the purposes of Government (including payments by way of minimum royalty);

and the reproduction or publication of any model or document in connection with the said use for the purposes of Government shall not be deemed to be an infringement of any copyright subsisting in the model or document.

(*2*) Where the patent, or the right to apply for or obtain the patent, has been assigned to the patentee in consideration of royalties or other benefits determined by reference to the use of the invention (including payments by way of minimum royalty), then, in relation to any use of the invention made for the purposes of Government by the patentee to the order of the Central Government, sub-section (*3*) of section 100 shall have effect as if that use were made by virtue of an authority given under that section; and any use of the invention for the purposes of Government by virtue of sub-section (*3*) of that section shall have effect as if the reference to the patentee included a reference to the assignor of the patent, and any sum payable by virtue of that sub-section shall be divided between the patentee and the assignor in such proportion as may be agreed upon between them or as may in default of agreement be determined by the High Court on a reference under section 103.

(*3*) Where by virtue of sub-section (*3*) of section 100, payments are required to be made by the Central Government or persons authorised under sub-section (*1*) of that section in respect of the use of an invention for the purposes of Government and where in

respect of such patent there is an exclusive licensee authorised under his licence to use the invention for the purposes of Government, such sum shall be shared by the patentee and such licensee in such proportions, if any, as may be agreed upon between them or as may in default of agreement be determined by the High Court on a reference under section 103 to be just, having regard to any expenditure incurred by the licensee—

(*a*) in developing the said invention, or

(*b*) in making payments to the patentees other than royalties or other benefits determined by reference to the use of the invention, including payments by way of minimum royalty in consideration of the licence.

Acquisition of inventions and patents by the Central Government.

102. (*1*) The Central Government may, if satisfied that it is necessary that an invention which is the subject of an application for a patent or a patent should be acquired from the applicant or the patentee for a public purpose, publish a notification to that effect in the Official Gazette, and thereupon the invention or patent and all rights in respect of the invention or patent shall, by force of this section, stand transferred to and be vested in the Central Government.

(*2*) Notice of the acquisition shall be given to the applicant, and, where a patent has been granted, to the patentee and other persons, if any, appearing in the register as having an interest in the patent.

(*3*) The Central Government shall pay to the applicant, or, as the case may be, the patentee and other persons appearing on the register as having an interest in the patent such compensation as may be agreed upon between the Central Government and the applicant, or the patentee and other persons; or, as may in default of agreement, be determined by the High Court on a reference under section 103 to be just having regard to the expenditure incurred in connection with the invention and, in the case of a patent, the term thereof, the period during which and the manner in which it has already been worked (including the profits made during such period by the patentee or by his licensee whether exclusive or otherwise) and other relevant factors.

Reference to High Court of disputes as to use for purposes of Government.

103. (*1*) Any dispute as to the exercise by the Central Government or a person authorised by it of the powers conferred by section 100, or as to terms for the use of an invention for the purposes of Government thereunder or as to the right of any person to receive any part of a payment made in pursuance of sub-section (*3*) of that section or as to the amount of compensation payable for the aquisition of an invention or a patent under section 102, may be

referred to the High Court by either party to the dispute in such manner as may be prescribed by the rules of the High Court.

(2) In any proceedings under this section to which the Central Government is a party, the Central Government may—

(a) if the patentee is a party to the proceedings, petition by way of counter-claim for revocation of the patent on any ground upon which a patent may be revoked under section 64; and

(b) whether a patentee is or is not a party to the proceedings, put in issue the validity of the patent without petitioning for its revocation.

(3) If in such proceedings as aforesaid any question arises whether an invention has been recorded, tested or tried as is mentioned in section 100, and the disclosure of any document regarding the invention, or of any evidence of the test or trial thereof, would, in the opinion of the Central Government, be prejudicial to the public interest, the disclosure may be made confidentially to the advocate of the other party or to an independent expert mutually agreed upon.

(4) In determining under this section any dispute between the Central Government and any person as to terms for the use of an invention for the purposes of Government, the High Court shall have regard to any benefit or compensation which that person or any person from whom he derives title, may have received, or may be entitled to receive, directly or indirectly in respect of the use of the invention in question for the purposes of Government.

(5) In any proceedings under this section, the High Court may at any time order the whole proceedings or any question or issue of fact arising therein to be referred to an official referee, commissioner or an arbitrator on such terms as the High Court may direct, and references to the High Court in the foregoing provisions of this section shall be construed accordingly.

(6) Where the invention claimed in a patent was made by a person who at the time it was made was in the service of the Central Government or of a State Government or was an employee of a Government undertaking and the subject-matter of the invention is certified by the relevant Government or the principal officer of the Government undertaking to be connected with the work done in the course of the normal duties of the Government servant or employee

of the Government undertaking, then, notwithstanding anything contained in this section, any dispute of the nature referred to in sub-section (*1*) relating to the invention shall be disposed of by the Central Government conformably to the provisions of this section so far as may be applicable, but before doing so the Central Government shall give an opportunity to the patentee and such other parties as it considers have an interest in the matter to be heard.

CHAPTER XVIII

SUITS CONCERNING INFRINGEMENT OF PATENTS

Jurisdiction.

104. No suit for a declaration under section 105 or for any relief under section 106 or for infringement of a patent shall be instituted in any court inferior to a district court having jurisdiction to try the suit.

Power of court to make declaration as to non-infringement.

105. (*1*) Notwithstanding anything contained in section 34 of the Specific Relief Act, 1963, any person may institute a suit for a declaration that the use by him of any process, or the making, use or sale of any article by him, does not, or would not, constitute an infringement of a claim of a patent against the patentee or the holder of an exclusive licence under the patent, notwithstanding that no assertion to the contrary has been made by the patentee or the licensee, if it is shown— 47 of 1963.

(*a*) that the plaintiff has applied in writing to the patentee or exclusive licensee for a written acknowledgment to the effect of the declaration claimed and has furnished him with full particulars in writing of the process or article in question; and

(*b*) that the patentee or licensee has refused or neglected to give such an acknowledgment.

(*2*) The costs of all parties in a suit for a declaration brought by virtue of this section shall, unless for special reasons the court thinks fit to order otherwise, be paid by the plaintiff.

(*3*) The validity of a claim of the specification of a patent shall not be called in question in a suit for a declaration brought by virtue of this section, and accordingly the making or refusal of such a declaration in the case of a patent shall not be deemed to imply that the patent is valid or invalid.

(*4*) A suit for a declaration may be brought by virtue of this section at any time after the date of advertisement of acceptance of the complete specification of a patent, and references in this section to the patentee shall be construed accordingly.

Power of Court to grant relief in cases of groundless threats of infringement proceedings.

106. (*1*) Where any person (whether entitled to or interested in a patent or an application for a patent or not) threatens any other person by circulars or advertisements or by communications, oral or in writing, addressed to that or any other person, with proceedings for infringement of a patent, any person aggrieved thereby may bring a suit against him praying for the following reliefs, that is to say—

(*a*) a declaration to the effect that the threats are unjustifiable;

(*b*) an injunction against the continuance of the threats; and

(c) such damages, if any, as he has sustained thereby.

(*2*) Unless in such suit the defendant proves that the acts in respect of which the proceedings were threatened constitute or, if done, would constitute, an infringement of a patent or of rights arising from the publication of a complete specification in respect of a claim of the specification not shown by the plaintiff to be invalid, the court may grant to the plaintiff all or any of the reliefs prayed for.

Explanation.—A mere notification of the existence of a patent does not constitute a threat of proceeding within the meaning of this section.

Defences in suits for infringement.

107. In any suit for infringement of a patent, every ground on which it may be revoked under section 64 shall be available as a ground for defence.

Reliefs in suits for infringement.

108. The reliefs which a court may grant in any suit for infringement include an injunction (subject to such terms, if any, as the court thinks fit) and, at the option of the plaintiff, either damages or an account of profits.

Right of exclusive licensee to take proceedings against infringement.

109. (*1*) The holder of an exclusive licence shall have the like right as the patentee to institute a suit in respect of any infringement of the patent committed after the date of the licence, and in awarding damages or an account of profits or granting any other relief in any such suit the court shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such or, as the case may be, the profits earned by means of the infringement so far as it constitutes an infringement of the rights of the exclusive licensee as such.

(*2*) In any suit for infringement of a patent by the holder of an exclusive licence under sub-section (*1*), the patentee shall, unless he has joined as a plaintiff in the suit, be added as a defendant, but a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

Right of licensee under section 84 to take proceedings against infringement.

110. Any person to whom a licence has been granted under section 84 shall be entitled to call upon the patentee to take proceedings to prevent any infringement of the patent, and, if the patentee refuses or neglects to do so within two months after being so called upon, the licensee may institute proceedings for the infringement in his own name as though he were the patentee, making the patentee a defendant; but a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

Restriction on power of court to grant damages or account of profits for infringement.

111. (*1*) In a suit for infringement of a patent damages or an account of profits shall not be granted against the defendant who proves that at the date of the infringement he was not aware and had no reasonable grounds for believing that the patent existed.

Explanation.—A person shall not be deemed to have been aware or to have had reasonable grounds for believing that a patent exists by reason only of the application to an article of the word 'Patent', 'Patented' or any word or words expressing or implying that a patent has been obtained for the article, unless the number of the patent accompanies the word or words in question.

(*2*) In any suit for infringement of a patent the court may, if it thinks fit, refuse to grant any damages or an account of profits in respect of any infringement committed after a failure to pay any renewal fee within the prescribed period and before any extension of that period.

(*3*) Where an amendment of a specification by way of disclaimer, correction or explanation has been allowed under this Act after the publication of the specification, no damages or account of profits shall be granted in any proceeding in respect of the use of the invention before the date of the decision allowing the amendment, unless the court is satisfied that the specification as originally published was framed in good faith and with reasonable skill and knowledge.

(*4*) Nothing in this section shall affect the power of the court to grant an injunction in any suit for infringement of a patent.

Restriction on power of court.

112. If in proceedings for the infringement of a patent endorsed or deemed to be endorsed with the words "Licences of right" (otherwise than by the importation of the patented article from other countries) the infringing defendant is ready and willing to take a licence upon terms to be settled by the Controller as provided in section 88, no

injunction shall be granted against him, and the amount (if any) recoverable against him by way of damages shall not exceed double the amount which would have been recoverable against him as licensee if such a licence had been granted before the earliest infringement. to grant injunction in certain cases.

113. (*1*) If in any proceedings before a High Court for the revocation of a patent under section 64 the validity of any claim of a specification is contested and that claim is found by the court to be valid, the Court may certify that the validity of that claim was contested in those proceedings and was upheld. Certificate of validity of specification and costs of subsequent suits for infringement thereof.

(*2*) Where any such certificate has been granted, then, if in any subsequent suit before a court for infringement of that claim of the patent or in any subsequent proceeding for revocation of the patent in so far as it relates to that claim, the patentee or other person relying on the validity of the claim obtains a final order or judgment in his favour, he shall be entitled to an order for the payment of his full costs, charges and expenses of and incidental to any such suit or proceeding properly incurred so far as they concern the claim in respect of which the certificate was granted, unless the court trying the suit or proceeding otherwise directs.

Provided that the costs as specified in this sub-section shall not be ordered when the party disputing the validity of the claim satisfies the court that he was not aware of the grant of the certificate when he raised the dispute and withdrew forthwith such defence when he became aware of such a certificate.

(*3*) Nothing contained in this section shall be construed as authorising courts hearing appeals from decrees or orders in suits for infringement or petitions for revocation to pass orders for costs on the scale referred to therein.

114. (*1*) If in proceedings for infringement of a patent it is found that any claim of the specification, being a claim in respect of which infringement is alleged, is valid, but that any other claim is invalid, the court may grant relief in respect of any valid claim which is infringed: Relief for infringement of partially valid specification.

Provided that the court shall not grant relief except by way of injunction save in the circumstances mentioned in sub-section (*2*)

(2) Where the plaintiff proves that the invalid claim was framed in good faith and with reasonable skill and knowledge, the court shall grant relief in respect of any valid claim which is infringed subject to the discretion of the court as to costs and as to the date from which damages or an account of profits should be reckoned, and in exercising such discretion the court may take into consideration the conduct of the parties in inserting such invalid claims in the specification or permitting them to remain there.

Scientific advisers.

115. (1) In any suit for ingringement or in any proceeding before a court under this Act, the court may at any time, and whether or not an application has been made by any party for that purpose, appoint an independent scientific adviser to assist the court or to inquire and report upon any such question of fact or of opinion (not involving a question or interpretation of law) as it may formulate for the purpose.

(2) The remuneration of the scientific adviser shall be fixed by the court and shall include the costs of making a report and a proper daily fee for any day on which the scientific adviser may be required to attend before the court, and such remuneration shall be defrayed out of moneys provided by Parliament by law for the purpose.

CHAPTER XIX

APPEALS

Appeals.

116. (1) No appeal shall lie from any decision, order or direction made or issued under this Act by the Central Government, or from any act or order of the Controller for the purpose of giving effect to any such decision, order or direction.

(2) Save as otherwise expressly provided in sub-section (1), an appeal shall lie to a High Court from any decision, order or direction of the Controller under any of the following provisions, that is to say,

section 15, section 16, section 17, section 18, section 19, section 20, section 25, section 27, section 28, section 51, section 54, section 57, section 60, section 61, section 63, sub-section (3) of section 69, section 78, section 86 and section 89.

(3) Every appeal under this section shall be in writing and shall be made within three months from the date of the decision, order or direction, as the case may be, of the Controller, or within such further time as the High Court may in accordance with the rules made by it under section 158 allow.

Procedure for hearing of appeals.

117. (*1*) Every appeal before a High Court under section 116 shall be by petition and shall be in such form and shall contain such particulars as may be prescribed by rules made by the High Court under section 158.

(*2*) Every such appeal shall be heard by a single Judge of the High Court:

Provided that any such Judge may, if he so thinks fit, refer the appeal at any stage of the proceeding to a Bench of the High Court.

(*3*) Where an appeal is heard by a single Judge, a further appeal shall lie to a Bench of the High Court.

CHAPTER XX

PENALTIES

contravention of secrecy provisions relating to certain inventions

118. If any person fails to comply with any direction given under section 35 or makes or causes to be made an application for the grant of a patent in contravention of section 39, he shall be punishable with imprisonment for a term which may extend to two years, or with fine, or with both.

Falsification of entries in register, etc.

119. If any person makes, or causes to be made, a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in such a register, or produces or tenders, or causes to be produced or tendered, in evidence any such writing knowing the entry or writing to be false, he shall be punishable with imprisonment for a term which may extend to two years, or with fine, or with both.

Unauthorised claim of patent rights.

120. If any person falsely represents that any article sold by him is patented in India or is the subject of an application for a patent in India, he shall be punishable with fine which may extend to five hundred rupees.

Explanation 1.—For the purposes of this section, a person shall be deemed to represent—

(*a*) that an article is patented in India if there is stamped, engraved or impressed on, or otherwise applied to, the article the word "patent" or "patented" or some other word expressing or implying that a patent for the article has been obtained in India;

(*b*) that an article is the subject of an application for a patent in India, if there are stamped, engraved or impressed on, or otherwise applied to, the article the words "patent applied for", "patent pending", or some other words implying that an application for a patent for the article has been made in India.

Explanation 2.—The use of words "patent", "patented", "patent applied for", "patent pending" or other words expressing or implying that an article is patented or that a patent has been applied for shall be deemed to refer to a patent in force in India, or to a pending application for a patent in India, as the case may be, unless there is an accompanying indication that the patent has been obtained or applied for in any country outside India.

Wrongful use of words "patent office".

121. If any person uses on his place of business or any document issued by him or otherwise the words "patent office" or any other words which would reasonably lead to the belief that his place of business is, or is officially connected with, the patent office, he shall be punishable with imprisonment for a term which may extend to six months, or with fine, or with both.

Refusal or failure to supply information.

122. (*1*) If any person refuses or fails to furnish—

(*a*) to the Central Government any information which he is required to furnish under sub-section (5) of section 100,

(*b*) to the Controller any information or statement which he is required to furnish under section 146,

he shall be punishable with fine which may extend to one thousand rupees.

(*2*) If any person, being required to furnish any such information as is referred to in sub-section (*1*), furnishes information or statement which is false, and which he either knows or has reason to believe to be false or does not believe to be true, he shall be punishable with imprisonment which may extend to six months, or with fine, or with both.

Practice by non-registered patent agents.

123. If any person contravenes the provisions of section 129, he shall be punishable with fine which may extend to five hundred rupees in the case of a first offence and two thousand rupees in the case of a second or subsequent offence.

Offences by companies.

124. (*1*) If the person committing an offence under this Act is a company, the company as well as every person in charge of, and responsible to, the company for the conduct of its business at the time of the commission of the offence shall be deemed to be guilty of the offence and shall be liable to be proceeded against and punished accordingly:

Provided that nothing contained in this sub-section shall render any such person liable to any punishment if he proves that the offence was committed without his knowledge or that he exercised all due diligence to prevent the commission of such offence.

(2) Notwithstanding anything contained in sub-section (1), where an offence under this Act has been committed by a company and it is proved that the offence has been committed with the consent or connivance of, or that the commission of the offence is attributable to any neglect on the part of any director, manager, secretary or other officer of the company, such director, manager, secretary or other officer shall also be deemed to be guilty of that offence and shall be liable to be proceeded against and punished accordingly.

Explanation.—For the purposes of this section,—

(*a*) "company" means any body corporate and includes a firm or other association of individuals; and

(*b*) "director", in relation to a firm, means a partner in the firm.

CHAPTER XXI

PATENT AGENTS

Register of patent agents.

125. The Controller shall maintain a register to be called the register of patent agents in which shall be entered the names and addresses of all persons qualified to have their names so entered under section 126.

Qualifications for registration as patent agents.

126. A person shall be qualified to have his name entered in the register of patent agents if he fulfils the following conditions, namely,—

(*a*) he is a citizen of India: provided that this clause shall not apply to a person not a citizen of India who possesses the qualifications specified in sub-clause (*iii*) of clause (c);

(*b*) he has completed the age of 21 years;

(c) he has obtained a degree in physical science or engineering from any University in the territory of India or possesses such other equivalent scientific or technical qualifications as the Central Government may specify in this behalf, and, in addition,—

(*i*) is an advocate within the meaning of the Advocates Act, 1961; or

25 of 1961.

(*ii*) has passed the qualifying examination prescribed for the purpose; or

(*iii*) has been practising as a patent agent for a period of not less than five years before the commencement of this Act and has filed not less than twenty complete specifications during that period; or

(*iv*) has served in the office of the Controller as an examiner of patents or in any higher capacity for a period of not less than seven years:

Provided that he had not exercised the functions of a hearing officer for a period exceeding twelve months in all during his tenure of office;

(*d*) he has paid such fee as may be prescribed.

Rights of patent agents.

127. Subject to the provisions contained in this Act and in any rules made thereunder, every patent agent whose name is entered in the register shall be entitled—

(*a*) to practise before the Controller; and

(*b*) to prepare all documents, transact all business and discharge such other functions as may be prescribed in connection with any proceeding before the Controller under this Act.

Subscription and verification of certain documents by patent agents.

128. (*1*) Subject to the provisions contained in sub-section (*2*) and to any rules made under this Act, all applications and communications to the Controller under this Act may be signed by a patent agent authorised in writing in this behalf by the person concerned.

(*2*) The following documents, namely,—

(*i*) applications for patents;

(*ii*) applications for the restoration of lapsed patents;

(*iii*) applications for the sealing of patents after the time allowed for that purpose by or under sub-section (*2*) of section 43 has expired;

(*iv*) applications for leave to amend;

(*v*) applications for compulsory licences or for revocation; and

(*vi*) notices of surrender of patents

shall be signed and verified in the manner prescribed by the person making such applications or giving such notices:

Provided that if such person is absent from India, they may be signed and verified on his behalf by a patent agent authorised by him in writing in that behalf.

Restrictions on practice as patent agents.

129. (*1*) No person, either alone or in partnership with any other person, shall practise, describe or hold himself out as a patent agent, or permit himself to be so described or held out, unless he is registered as a patent agent or, as the case may be, unless he and all his partners are so registered.

(*2*) No company or other body corporate shall practise, describe itself or hold itself out as patent agents or permit itself to be so described or held out.

Explanation.—For the purposes of this section, practise as a patent agent includes any of the following acts, namely:—

(*a*) applying for or obtaining patents in India or elsewhere;

(*b*) preparing specifications or other documents for the purposes of this Act or of the patent law of any other country;

(*c*) giving advice other than of a scientific or technical nature as to the validity of patents or their infringement.

Removal from register of patent agents and restoration.

130. (*1*) The Central Government may remove the name of any person from the register when it is satisfied, after giving that person a reasonable opportunity of being heard and after such further inquiry, if any, as it thinks fit to make—

(*i*) that his name has been entered in the register by error or on account of misrepresentation or suppression of material fact;

(*ii*) that he has been convicted of any offence and sentenced to a term of imprisonment or has been guilty of misconduct in his professional capacity which in the opinion of the Central Government renders him unfit to be kept in the register.

(*2*) The Central Government may, on application and on sufficient cause being shown, restore to the register the name of any person removed therefrom.

Power of Controller to refuse to deal with certain agents.

131. (*1*) Subject to any rules made in this behalf, the Controller may refuse to recognise as agent in respect of any business under this Act—

(*a*) any individual whose name has been removed from, and not restored to, the register, or who is for the time being suspended from acting as a patent agent;

(*b*) any person who has been convicted of an offence under section 123;

(*c*) any person, not being registered as a patent agent, who in the opinion of the Controller is engaged wholly or mainly in acting as agent in applying for patents in India or elsewhere in the name or for the benefit of the person by whom he is employed;

(*d*) any company or firm, if any person whom the Controller could refuse to recognise as agent in respect of any business under this Act, is acting as a director or manager of the company or is a partner in the firm.

(*2*) The Controller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in India.

Savings in respect of other persons authorised to act as agents.

132. Nothing in this Chapter shall be deemed to prohibit—

(*a*) the applicant for a patent or any person, not being a patent agent, who is duly authorised by the applicant from drafting any specification or appearing or acting before the Controller; or

(*b*) an advocate, not being a patent agent, from taking part in any proceedings under this Act otherwise than by way of drafting any specification.

CHAPTER XXII

INTERNATIONAL ARRANGEMENTS

Notification as to convention countries.

133. (*1*) With a view to the fulfilment of a treaty, convention or arrangement with any country outside India which affords to applicants for patents in India or to citizens of India similar privileges as are granted to its own citizens in respect of the grant of patents and the protection of patent rights, the Central Government may, by notification in the Official Gazette, declare such country to be a convention country for the purposes of this Act.

(*2*) A declaration under sub-section (*1*) may be made for the purposes either of all or of some only of the provisions of this Act, and a country in the case of which a declaration made for the purposes of some only of the provisions of this Act is in force shall be deemed to be a convention country for the purposes of those provisions only.

Notification as to countries not providing for reciprocity.

134. Where any country specified by the Central Government in this behalf by notification in the Official Gazette does not accord to citizens of India the same rights in respect of the grant of patents and the protection of patent rights as it accords to its own nationals, no

national of such country shall be entitled, either solely or jointly with any other person,—

(*a*) to apply for the grant of a patent or be registered as the proprietor of a patent;

(*b*) to be registered as the assignee of the proprietor of a patent; or

(*c*) to apply for a licence or hold any licence under a patent granted under this Act.

Convention applications.

135. (*1*) Without prejudice to the provisions contained in section 6, where a person has made an application for a patent in respect of an invention in a convention country (hereinafter referred to as the "basic application"), and that person or the legal representative or assignee of that person makes an application under this Act for a patent within twelve months after the date on which the basic application was made, the priority date of a claim of the complete specification, being a claim based on matter disclosed in the basic application, is the date of making of the basic application.

Explanation.—Where applications have been made for similar protection in respect of an invention in two or more convention countries, the period of twelve months referred to in this sub-section shall be reckoned from the date on which the earlier or earliest of the said applications was made.

(*2*) Where applications for protection have been made in one or more convention countries in respect of two or more inventions which are cognate or of which one is a modification of another, a single convention application may, subject to the provisions contained in section 10, be made in respect of those inventions at any time within twelve months from the date of the earliest of the said applications for protection:

Provided that the fee payable on the making of any such application shall be the same as if separate applications have been made in respect of each of the said inventions, and the requirements of clause (*b*) of sub-section (*1*) of section 136 shall, in the case of any such application, apply separately to the applications for protection in respect of each of the said inventions.

Special provisions relating to convention applications.

136. (*1*) Every convention application shall—

(*a*) be accompanied by a complete specification; and

(*b*) specify the date on which and the convention country in which the application for protection, or, as the case may be, the first of such applications was made; and

(*c*) state that no application for protection in respect of the invention had been made in a convention country before that

date by the applicant or by any person from whom he derives title.

(2) Subject to the provisions contained in section 10, a complete specification filed with a convention application may include claims in respect of developments of, or additions to, the invention in respect of which the application for protection was made in a convention country, being developments or additions in respect of which the applicant would be entitled under the provisions of section 6 to make a separate application for a patent.

(3) A convention application shall not be post-dated under sub-section (1) of section 17 to a date later than the date on which under the provisions of this Act the application could have been made.

Multiple priorities.

137. (1) Where two or more applications for patents in respect of inventions have been made in one or more convention countries and those inventions are so related as to constitute one invention, one application may be made by any or all of the persons referred to in sub-section (1) of section 135 within twelve months from the date on which the earlier or earliest of those applications was made, in respect of the inventions disclosed in the specifications which accompanied the basic applications.

(2) The priority date of a claim of the complete specification, being a claim based on matters disclosed in one or more of the basic applications, is the date on which that matter was first so disclosed.

(3) For the purposes of this Act, a matter shall be deemed to have been disclosed in a basic application for protection in a convention country if it was claimed or disclosed (otherwise than by way of disclaimer or acknowledgment of a prior act) in that application, or any documents submitted by the applicant for protection in support of and at the same time as that application, but no account shall be taken of any disclosure effected by any such document unless a copy of the document is filed at the patent office with the convention application or within such period as may be prescribed after the filing of that application.

Supplementary provisions as to convention applications.

138. (1) Where a convention application is made in accordance with the provisions of this Chapter, the applicant shall furnish, in addition to the complete specification, copies of the specifications or corresponding documents filed or deposited by the applicant in the patent office of the convention country in which the basic application was made, certified by the official chief or head of the patent office of the convention country, or otherwise verified to the satisfaction of the Controller, along with the application or within three months thereafter, or within such further period as the Controller may on good cause allow.

(2) If any such specification or other document is in a foreign language, a translation into English of the specification or document, verified by affidavit or otherwise to the satisfaction of the Controller, shall be annexed to the specification or document.

(3) For the purposes of this Act, the date on which an application was made in a convention country is such date as the Controller is satisfied, by certificate of the official chief or head of the patent office of the convention country or otherwise, is the date on which the application was made in that convention country.

Other provisions of Act to apply to convention applications.

139. Save as otherwise provided in this Chapter, all the provisions of this Act shall apply in relation to a convention application and a patent granted in pursuance thereof as they apply in relation to an ordinary application and a patent granted in pursuance thereof.

CHAPTER XXIII

MISCELLANEOUS

Avoidance of certain restrictive conditions

140. (1) It shall not be lawful to insert—

(i) in any contract for or in relation to the sale or lease of a patented article or an article made by a patented process; or

(ii) in a licence to manufacture or use a patented article; or

(iii) in a licence to work any process protected by a patent,

a condition the effect of which may be -

(a) to require the purchaser, lessee, or licensee to acquire from the vendor, lessor, or licensor, or his nominees, or to prohibit him from acquiring or to restrict in any manner or to any extent his right to acquire from any person or to prohibit him from acquiring except from the vendor, lessor, or licensor or his nominees, any article other than the patented article or an article other than that made by the patented process; or

(b) to prohibit the purchaser, lessee or licensee from using, or to restrict in any manner or to any extent the right of the purchaser, lessee or licensee, to use an article other than the patented article or an article other than that made by the patented process, which is not supplied by the vendor, lessor or licensor or his nominee; or

(c) to prohibit the purchaser, lessee or licensee from using, or to restrict in any manner or to any extent the right of the

purchaser, lessee or licensee to use any process other than the patented process;

and any such condition shall be void.

(2) A condition of the nature referred to in clause (*a*) or clause (*b*) or clause (*c*) of sub-section (*1*) shall not cease to be a condition falling within that sub-section merely by reason of the fact that the agreement containing it has been entered into separately, whether before or after the contract relating to the sale, lease or licence of the patented article or process.

(3) In proceedings against any person for the infringement of a patent, it shall be a defence to prove that at the time of the infringement there was in force a contract relating to the patent and containing a condition declared unlawful by this section:

Provided that this sub-section shall not apply if the plaintiff is not a party to the contract and proves to the satisfaction of the court that the restrictive condition was inserted in the contract without his knowledge and consent, express or implied.

(4) Nothing in this section shall—

(*a*) affect a condition in a contract by which a person is prohibited from selling goods other than those of a particular person;

(*b*) validate a contract which, but for this section, would be invalid;

(*c*) affect a condition in a contract for the lease of, or licence to use, a patented article, by which the lessor or licensor reserves to himself or his nominee the right to supply such new parts of the patented article as may be required or to put or keep it in repair.

(5) The provisions of this section shall also apply to contracts made before the commencement of this Act if, and in so far as, any restrictive conditions declared unlawful by this section continue in force after the expiration of three months from such commencement.

Determination of certain contracts.

141. (*1*) Any contract for the sale or lease of a patented article or for licence to manufacture, use or work a patented article or process, or relating to any such sale, lease or licence, whether made before or after the commencement of this Act, may at any time after the patent or all the patents by which the article or process was

protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything to the contrary in the contract or in any other contract, be determined by the purchaser, lessee, or licensee, as the case may be, of the patent on giving three months notice in writing to the other party.

(2) The provisions of this section shall be without prejudice to any right of determining a contract exercisable apart from this section.

Fees.

142. (1) There shall be paid in respect of the grant of patents and applications therefor, and in respect of other matters in relation to the grant of patents under this Act, such fees as may be prescribed by the Central Government.

(2) Where a fee is payable in respect of the doing of an act by the Controller, the Controller shall not do that act until the fee has been paid.

(3) Where a fee is payable in respect of the filing of a document at the patent office, the document shall be deemed not to have been filed at the office until the fee has been paid.

(4) Where a principal patent is granted later than two years from the date of the application for patent, the fees which have become due in the meantime may be paid within a term of three months from the date of the recordal of the patent in the register.

Restrictions upon publication of specifications.

143. Subject to the provisions of Chapter VII, an application for a patent, and any specification filed in pursuance thereof, shall not, except with the consent of the applicant, be published by the Controller or be open to public inspection at any time before the date of advertisement of acceptance of the application in pursuance of section 23.

Reports of examiners to be confidential.

144. The reports of examiners to the Controller under this Act shall not be open to public inspection or be published by the Controller; and such reports shall not be liable to production or inspection in any legal proceeding unless the court certifies that the production or inspection is desirable in the interests of justice, and ought to be allowed:

Provided that the Controller may, on application made in the prescribed manner, by any person, disclose the result of any search made under section 13 in respect of any application for a patent where the complete specification has been published.

Publication of patented inventions

145. The Controller shall issue periodically a publication of patented inventions containing such information as the Central Government may direct.

Power of Controller to call for information from patentees

146. The Controller may, at any time during the continuance of the patent, by notice in writing, require a patentee or a licensee, exclusive or otherwise, to furnish to him within two months from the date of such notice or within such further time as the Controller may allow, such information or such periodical statements as to the extent to which the patented invention has been commercially worked in India as may be specified in the notice.

Evidence of entries, documents, etc.

147. (*1*) A certificate purporting to be signed by the Controller as to any entry, matter or thing which he is authorised by this Act or any rules made thereunder to make or do, shall be *prima facie* evidence of the entry having been made and of the contents thereof and of the matter or thing having been done or omitted to be done.

(*2*) A copy of any entry in any register or of any document kept in the patent office or of any patent, or an extract from any such register or document, purporting to be certified by the Controller and sealed with the seal of the patent office shall be admitted in evidence in all courts, and in all proceedings, without further proof or production of the original

(*3*) The Controller or any other officer of the patent office shall not, in any legal proceedings to which he is not a party, be compellable to produce the register or any other document in his custody, the contents of which can be proved by the production of a certified copy issued under this Act or to appear as a witness to prove the matters therein recorded unless by order of the court made for special causes.

Declaration by infant, lunatic, etc.

148. (*1*) If any person is, by reason of minority, lunacy or other disability, incapable of making any statement or doing anything required or permitted by or under this Act, the lawful guardian, committee or manager (if any) of the person subject to the disability, or if there be none, any person appointed by any court possessing jurisdiction in respect of his property, may make such statement or a statement as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability.

(*2*) An appointment may be made by the court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the statement or the doing of the thing.

Service of notices, etc., by post.

149. Any notice required or authorised to be given by or under this Act, and any application or other document so authorised or required to be made or filed, may be given, made or filed by post.

Security for costs.

150. If any party by whom notice of any opposition is given under this Act or by whom application is made to the Controller for the grant of a licence under a patent neither resides nor carries on business in India, the Controller may require him to give security for the costs of the proceedings, and in default of such security being given may treat the opposition or application as abandoned.

Transmission of orders of courts to Controller.

151. (*1*) Every order of the High Court on a petition for revocation, including orders granting certificates of validity of any claim, shall be transmitted by the High Court to the Controller who shall cause an entry thereof and reference thereto to be made in the register.

(*2*) Where in any suit for infringement of a patent or in any suit under section 106 the validity of any claim or a specification is contested and that claim is found by the court to be valid or not valid, as the case may be, the court shall transmit a copy of its judgment and decree to the Controller who shall on receipt thereof cause an entry in relation to such proceeding to be made in the prescribed manner in a supplemental record.

(*3*) The provisions of sub-sections (*1*) and (*2*) shall also apply to the court to which appeals are preferred against decisions of the courts referred to in those sub-sections.

Transmission of copies of specifications, etc., and inspection thereof.

152. Copies of all such specifications, drawings and amendments left at the patent office as become open to public inspection under the provisions of this Act, shall be transmitted, as soon as may be, after the printed copies thereof are available, to such authorities as the Central Government may appoint in this behalf, and shall be open to the inspection of any person at all reasonable times at places to be specified by those authorities and with the approval of the Central Government.

Information relating to patents.

153. A person making a request to the Controller in the prescribed manner for information relating to any such matters as may be prescribed as respects any patent specified in the request or as respects any application for a patent so specified shall be entitled, subject to the payment of the prescribed fee, to have information supplied to him accordingly.

Loss or destruction of patent.

154. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the Controller, the Controller may at any time, on application made in the prescribed manner and on

payment of the prescribed fee, cause a duplicate thereof to be sealed and delivered to the applicant.

Reports of Controller to be placed before Parliament.

155. The Central Government shall cause to be placed before both Houses of Parliament once a year a report respecting the execution of this Act by or under the Controller.

Patent to bind Government.

156. Subject to the other provisions contained in this Act, a patent shall have to all intents the like effect as against Government as it has against any person.

Right of Government to sell or use forfeited articles.

157. Nothing in this Act shall affect the power of the Government or of any person deriving title directly or indirectly from the Government to sell or use any articles forfeited under any law for the time being in force.

Power of High Courts to make rules.

158. The High Court may make rules consistent with this Act as to the conduct and procedure in respect of all proceedings before it under this Act.

Power of Central Government to make rules.

159. (*1*) The Central Government may, by notification in the Official Gazette, make rules for carrying out the purposes of this Act.

(*2*) Without prejudice to the generality of the foregoing power, the Central Government may make rules to provide for all or any of the following matters, namely:—

(*i*) the form and manner in which any application for a patent, any specifications or drawings and any other application or document may be filed in the patent office;

(*ii*) the time within which any act or thing may be done under this Act, including the manner in which and the time within which any matter may be advertised under this Act;

(*iii*) the fees which may be payable under this Act and the manner of payment of such fees;

(*iv*) the matters in respect of which the examiner may make a report to the Controller;

(*v*) the form of request for the sealing of a patent;

(*vi*) the form and manner in which and the time within which any notice may be given under this Act;

(*vii*) the provisions which may be inserted in an order for restoration of a patent for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent had ceased;

(*viii*) the establishment of branch offices of the patent office and the regulation generally of the business of the patent office, including its branch offices;

(*ix*) the maintenance of the register of patents and the matters to be entered therein;

(*x*) the matters in respect of which the Controller shall have powers of a civil court;

(*xi*) the time when and the manner in which the register and any other document open to inspection may be inspected under this Act;

(*xii*) the qualifications of, and the preparation of a roll of, scientific advisers for the purpose of section 115;

(*xiii*) the form and manner in which appeals from the orders, decisions or directions of the Controller may be preferred to the Central Government, the procedure to be followed in connection therewith and the manner in which such appeals may be heard and disposed of by the Central Government;

(*xiv*) the manner in which any compensation for acquisition by Government of an invention may be paid;

(*xv*) the manner in which the register of patent agents may be maintained; the conduct of qualifying examinations for patent agents; and matters connected with their practice and conduct, including the taking of disciplinary proceedings against patent agents for misconduct;

(*xvi*) the regulation of the making, printing, publishing and selling of indexes to, and abridgments of, specifications and other documents in the patent office; and the inspection of indexes and abridgments and other documents;

(*xvii*) any other matter which has to be or may be prescribed.

(3) The power to make rules under this section shall be subject to the condition of the rules being made after previous publication.

Rules to be placed before Parliament

160. Every rule made under this Act shall be laid, as soon as may be after it is made, before each House of Parliament while it is in session for a total period of thirty days which may be comprised in one session or in two successive sessions, and, if before the expiry of the session in which it is so laid or in the session immediately following, both Houses agree in making any modification in the rule or both Houses agree that the rule should not be made, the rule shall thereafter have effect only in such modified form or be of no effect, as the case may be; so, however, that any such modification or annulment shall be without prejudice to the validity of anything previously done under that rule.

Special provisions with respect to certain applications deemed to have been refused under Act 2 of 1911.

161. (1) Where, as a result of action taken by the Controller under section 12 of the Atomic Energy Act, 1948, or under section 20 of the Atomic Energy Act, 1962, an application for a patent made before the commencement of this Act could not be accepted within the time specified for the purpose in the Indian Patents and Designs Act, 1911 (hereafter in this section referred to as the repealed Act), and, consequently, was deemed to have been refused by reason of sub-section (4) of section 5 of the repealed Act, the application may, if the applicant, or, if he is dead his legal representative, makes a request in that behalf to the Controller in the prescribed manner within three months from the commencement of this Act, be revived and shall be disposed of as if it were an application pending at the commencement of this Act to which the provisions of this Act apply by reason of sub-section (3) of section 162. 29 of 1948. 37 of 1962. 2 of 1911

(2) The Controller may, before proceeding to act upon any such request as is referred to in sub-section (1), refer the matter to the Central Government for directions as to whether the invention is one relating to atomic energy and shall act in conformity with the directions issued by it.

(3) Where in pursuance of any such application as is referred to in sub-section (1) a patent is granted, the rights of the patentee shall be subject to such conditions as the Controller thinks fit to impose for the protection or compensation of persons who may have begun to avail themselves of, or have taken definite steps by contract or otherwise to avail themselves of, the patented invention before the date of advertisement of the acceptance of the complete specification.

(4) No suit or other proceeding shall be commenced or prosecuted in respect of an infringement of a patent committed before the date of advertisement of the acceptance of the complete specification.

Repeal of Act 2 of 1911 in so far as it relates to patents and savings.

162. (1) The Indian Patents and Designs Act, 1911, in so far as it relates to patents, is hereby repealed, that is to say, the said Act shall be amended in the manner specified in the Schedule.

(2) Notwithstanding the repeal of the Indian Patents and Designs Act, 1911, in so far as it relates to patents, the provisions of section 21A of that Act and of any rules made thereunder shall continue to apply in relation to any patent granted before the commencement of this Act in pursuance of that section.

(3) Save as otherwise provided in sub-section (2), the provisions of this Act shall apply to any application for a patent pending at the commencement of this Act and to any proceedings consequent thereon and to any patent granted in pursuance thereof.

(4) The mention of particular matters in this section shall not prejudice the general application of the General Clauses Act, 1897, with respect to repeals.

10 of 1897.

Amendment of Act 43 of 1958.

163. In sub-section (1) of section 4 of the Trade and Merchandise Marks Act, 1958, the words and figures "and the Controller of Patents and Designs for the purposes of the Indian Patents and Designs Act, 1911" shall be omitted.

2 of 1911.

THE SCHEDULE

[*See* section 162]

AMENDMENTS TO THE INDIAN PATENTS AND DESIGNS ACT, 1911

1. Long title—Omit "Inventions and".

2. Preamble—Omit "inventions and".

3. Section 1—In sub-section (*1*) omit "Indian Patents and".

4. Section 2—

(*a*) omit clause (*1*);

(*b*) in clause (*2*) omit "(as respects designs)";

(*c*) for clause (*3*), substitute—

'(*3*) "Controller" means the Controller General of Patents, Designs and Trade Marks appointed under sub-section (*1*) of section 4 of the Trade and Merchandise Marks Act, 1958;"; 43 of 1958.

(*d*) in clause (*5*) for "trade mark as defined in section 478", substitute "trade mark as defined in clause (*v*) of sub-section (*1*) of section 2 of the Trade and Merchandise Marks Act, 1958"; 43 of 1958.

(*e*) omit clause (*6*);

(*f*) in clause (*7*), after sub-clause (*e*) insert—

"(*f*) in relation to the Union territories of Dadra and Nagar Haveli and Goa, Daman and Diu, the High Court of Bombay;

(*g*) in relation to the Union territory of Pondicherry, the High Court of Madras;";

(*g*) omit clauses (*8*), (*10*) *and* (*11*);

(*h*) for clause (*12*), substitute—

'(*12*) "Patent Office" means the patent office established under the Patents Act, 1965.'.

5. Omit Part I.

6. For section 51B, substitute—

"51B. A registered design shall have to all intents the like effect as against Government as it has against any person and the provisions of Chapter XVII of the Patents Act, 1965, shall apply to registered designs as they apply to patents.". Designs to bind Government.

7. In section 54, for "The provisions of this Act", substitute "The provisions of the Patents Act, 1965".

8. Omit sections 55 and 56.

9. Section 57—For sub-section (*1*), substitute—

"(*1*) There shall be paid in respect of the registration of designs and applications therefor and in respect of other matters relating to designs under this Act such fees as may be prescribed by the Central Government.".

10. Omit section 59A.

11. Section 61—Omit sub-section (*1*).

12. For section 62, substitute—

"62. The Controller may, on request in writing accompanied by the prescribed fee, correct any clerical error in the representation of a design or in the name or address of the proprietor of any design or in any other matter which is entered upon the register of designs.". Power of Controller to correct clerical errors.

13. Section 63—

(*a*) in sub-section (*1*), omit "to a patent or" and "patent or";

(*b*) in sub-section (*2*), omit "patent or" and for "patents or designs, as the case may be,", substitute "designs,";

(*c*) in sub-section (*3*), omit "patent or" wherever that expression occurs;

(*d*) in sub-section (*4*), omit "to a patent or".

14. Section 64—

(*a*) in sub-section (*1*), omit "patents or" and omit "either" wherever that word occurs;

(*b*) in sub-section (*5*), omit clause (*a*).

15. Omit section 66.

16. Section 67—Omit "for a patent, or for amendment of an application or of a specification, or".

17. Section 69—In sub-section (*1*), omit "to grant a patent for an invention or".

18. Section 71A—Omit "or from patents, specifications and other".

19. Omit section 72.

20. Omit sections 74A and 75.

21. Section 76—

(*a*) in sub-section (*1*), omit "other";

(*b*) in sub-section (*2*), in clause (*c*), omit "opponent".

22. Section 77—

(*a*) in sub-section (*1*)—

(*i*) in clauses (*c*) and (*d*), omit "specifications";

(*ii*) for clause (*e*), substitute—

"(*e*) providing for the inspection of documents in the patent office and for the manner in which they may be published;";

(*iii*) omit clause (*eee*);

(*b*) omit sub-section (*2A*).

23. Omit section 78.

24. For section 78A, substitute—

Reciprocal arrangement with United Kingdom and other Commonwealth countries.

"78A. (*1*) Any person who has applied for protection for any design in the United Kingdom or his legal representative or assignee shall, either alone or jointly with any other person, be entitled to claim that the registration of the said design under this Act shall be in priority to other applicants and shall have the same date as the date of the application in the United Kingdom:

Provided that—

(*a*) the application is made within six months from the application for protection in the United Kingdom; and

(*b*) nothing in this section shall entitle the proprietor of the design to recover damages for infringements happening prior to the actual date on which the design is registered in India.

(2) The registration of a design shall not be invalidated by reason only of the exhibition or use of, or the publication of a description or representation of, the design in India during the period specified in this section as that within which the application may be made.

(3) The application for the registration of a design under this section must be made in the same manner as an ordinary application under this Act.

(4) Where it is made to appear to the Central Government that the legislature of any such Commonwealth country as may be notified by the Central Government in this behalf has made satisfactory provision for the protection of designs registered in India, the Central Government may, by notification in the Official Gazette, direct that the provisions of this section, with such variations or additions, if any, as may be set out in such notification, shall apply for the protection of designs registered in that Commonwealth country.".

25. Omit the Schedule.

STATEMENT OF OBJECTS AND REASONS

The law relating to patents now on the statute book was enacted in 1911 and since then there have been substantial changes in the political and economic conditions of the country. Although the Act has been in force for a very long period, it has not achieved its main purpose of stimulating inventions among Indians and encouraging the development and exploitation of new inventions for industrial progress in this country. The need for a more comprehensive law so as to ensure that patent rights are not worked to the detriment of the consumer or to the prejudice of the trade or the industrial development of the country was felt as early as 1948 and in that year the Government appointed a Committee known as the Patents Enquiry Committee to review the working of the patents law in India with a view to ensure that the patent system became more conducive to national interests. An interim report of that Committee made in 1949 suggested the immediate amendment of the Indian Patents and Designs Act, 1911, so as to counteract the misuse or abuse of patent monopoly in India by the enactment of provisions for compulsory licensing. The recommendations contained in that interim report were given effect to by the Indian Patents and Designs (Amendment) Act, 1950. The final report of the Committee was presented to Government in 1950, and based on the final report a Bill further to amend the Indian Patents and Designs Act, 1911, was introduced in the Lok Sabha on the 7th December, 1953. While the Bill was pending, a further examination of the law revealed that the Bill would need extensive amendments and consequently it was not proceeded with and was allowed to lapse on the dissolution of the First Lok Sabha.

2. In 1957, the Government of India requested Shri N. Rajagopala Ayyangar, now a retired Judge of the Supreme Court, to examine afresh the law of patents in India and advise the Government on the changes necessary. The present Bill which is based mainly on the recommendations contained in his comprehensive report, incorporates a few further changes in the light of further examination particularly with reference to patents for food, medicines and drugs.

3. The Notes on Clauses explain in detail the various provisions contained in the Bill.

NEW DELHI; T. N. SINGH.

The 1st September, 1965.

PRESIDENT'S RECOMMENDATION UNDER ARTICLE 117 OF THE CONSTITUTION OF INDIA

[Copy of letter No. 14(1)-T.M.P./64-P&D, dated the 7th September, 1965 from Shri T. N. Singh, Minister of Industry in the Ministry of Industry and Supply to the Secretary, Lok Sabha.]

The President having been informed of the subject matter of the proposed Patents Bill, 1965, recommends consideration of the Bill in the Lok Sabha under article 117(3) of the Constitution of India.

Notes on clauses

Clause 2.—The definition of 'invention' in the existing Act has been modified so as to represent more accurately the existing position as defined by case-law. Several new definitions have also been included. For example, a definition of 'person' has been included in order to remove any doubt as to whether it includes the Government. A definition of 'Government undertaking' has become necessary in view of the occurrence of this expression in several places in the Bill. In the new definition of 'true and first inventor' it is made clear that it does not include the first importer of the invention and the first communicatee from abroad.

Clause 3.—In this clause are set out the several types of inventions or alleged inventions which are regarded universally or almost universally as not being patentable. In view of the non-availability of case-law on the subject in India, it would be advantageous to codify this part of the law as generally understood and applied.

Clause 4.—For making this law self-contained, a reference to section 20 of the Atomic Energy Act, 1962, is included under which no patent can be granted for inventions relating to atomic energy.

Clause 5.—In the case of inventions relating to baby and invalid food, medicines and drugs it would not be in the interests of an underdeveloped country like India to grant patents in respect of the substances themselves. But there is no such objection in relation to the processes involved. This clause accordingly restricts patentability to the processes involved in the manufacture or production of such substances.

Clause 6.—This replaces sub-section (*1*) of section 3 of the existing Act, but has been remodelled on the lines of section 34 of the Australian Patents Act, 1952 and section 1 of the U.K. Patents Act, 1949, by expressly including assignees, legal representatives, etc., among persons entitled to apply for patents.

Clause 7 dealing with the form of application seeks to make it clear that every application shall be for one invention only.

Clause 8.—As the majority of the applicants for patents in India are foreign nationals and as in several cases the application in India is for the same or substantially the same invention as that for which a patent has already been applied for in a foreign country, this clause

seeks to ensure that all relevant information as respects such foreign invention is made available to the Controller for the purpose of disposing of questions relating to novelty of invention, patentability, etc.

Clause 9.—This clause replaces section 4A of the existing Act. The increase in the time limit, namely, fifteen months in all in sub-clause (*1*) should benefit Indian nationals to get the complete specifications in proper order for being filed.

Clause 10.—This clause dealing with contents of specifications corresponds to section 4 of the existing Act but has been amplified in the light of section 4 of the U.K. Patents Act, 1949.

Clause 11.—This clause seeks to make provision respecting the priority date for each claim of a complete specification and is based on section 5 of the U.K. Patents Act, 1949, and sections 44 and 45 of the Australian Patents Act, 1952, but its scope is enlarged in order to provide for the various contingencies which may arise in the determination of the priority date for each such claim.

Clauses 12 *and* 13.—The existing Act does not contain any specific provision requiring the Controller to make a compulsory search for ascertaining the novelty of an invention before its acceptance. These clauses make it obligatory for searches to be made by the patent office in respect of all patent applications. Anticipation by publication is not to be confined to publication in India as at present and publication of an invention in India or any foreign country before the priority date claimed would constitute anticipation. Such a provision will enhance the commercial value attached to Indian patents.

Clause 14.—This clause is intended to make it clear that the applicant should be given an opportunity of being heard before any objections raised by the examiner are upheld by the Controller.

Clause 15 deals with the cases or circumstances in which an application for patent may be refused by the Controller.

Clauses 16 *to* 20.—Apart from the power to refuse an application, these clauses deal with the powers of the Controller to pass other suitable orders.

Under clause 16, where an application and the claims based thereon relate to more than one invention, the Controller may allow the applicant to amend the complete specification by confining it to a single invention.

Clause 17 deals with the powers of the Controller for the purpose of post-dating applications.

Clause 18 deals with the powers of the Controller in cases of anticipation.

Clause 19 deals with the powers of the Controller in cases where an invention cannot be performed without risk of infringement of some claim of an earlier patent.

Clause 20 deals with cases where substitution in the names of applicants becomes necessary.

Clause 21.—This clause provides for the maximum limit of time within which an application or a complete specification should be accepted if the application is not to be regarded as abandoned. As the subject-matter in all these cases is the complete specification, time should commence to run from the date of the complete specification and not from the date of the application as under section 5(4) of the existing Act. It would also be necessary to provide for further extension of time where delay takes place in the office of the Controller by reason of the investigations to be made by the examiner. Sub-clause (2) contains the necessary provisions in this behalf.

Clause 22 makes provisions similar to those contained in section 13(1) of the U.K. Patents Act, 1949, as respects acceptance of complete specification.

Clause 23 deals with advertisement of acceptance of the complete specification and replaces section 6 of the existing Act.

Clause 24.—This corresponds to section 7 of the existing Act except that the rights and privileges of the applicant commence not from the date of the acceptance of the application as in the existing Act but from the date of the acceptance of the complete specification.

Clause 25.—This clause purports to retain the existing procedure for opposition to the grant of patents as being necessary in the public interest, at the same time enlarging the grounds for opposition mentioned in section 9 of the existing Act.

Clause 26 deals with cases of 'obtaining' which are brought to light in opposition proceedings and seeks to authorise the Controller to deal suitably with the opponent's claim in such cases.

Clause 27.—This clause, modelled on section 15 of the U.K. Patents Act, 1949, would be useful where anticipatory publications are brought to the notice of the Controller with the informant filing a formal opposition to the grant.

Clause 28.—This clause seeks to give recognition to the right of the first inventor to be mentioned in the patent, if he so desires, although he may have parted with his proprietary interest therein.

Clauses 29 *to* 34 seek to afford guidance to the Controller in determining what constitutes anticipation under the other provisions of the law (for example, clause 13).

Clauses 35 *to* 42.—These clauses replace in a more comprehensive manner section 21A of the existing Act and are intended to secure that inventions relevant for defence purposes which are the subject matter of applications for patents are in the interests of national security kept secret. Any secrecy orders passed by the Controller in respect of such inventions are to be notified to the Central Government and are to be periodically reviewed. Though applications which are subject to secrecy directions may proceed up to the stage of acceptance they may not be advertised and no patent shall be granted in respect thereof. It is also provided that no person resident in India shall, except with the prior permission of the Controller apply for a patent outside India unless an application for patent for the same invention has been made in India not less than eight weeks before the application outside India and either no secrecy directions have been made in India or such directions have been revoked. Any contravention of secrecy directions will, apart from any criminal liability, render the applicant ineligible to proceed with the application. Payment by way of solatium is also provided for an applicant who may suffer hardship by reason of any secrecy directions.

Clause 43.—This clause seeks to replace section 10 of the existing Act in a modified form. Incidentally it removes the overall time limit specified in section 10(*2*) for the sealing of a patent as being too short and unnecessary.

Clause 45.—This clause replaces section 11 of the existing Act and makes the date of filing of the complete specification the date of the patent and not the date of the application as in the existing Act. [Compare section 22(1) of the U.K. Patents Act, 1949 and section 67(*1*) of the Australian Patents Act, 1952].

Clause 46 replaces section 12 of the existing Act relating to the effect, extent and form of patent in a modified form.

Clause 47 seeks to define in clear terms the rights of a patentee, rights which have at present to be determined with reference to decided cases. In the case of a patent for a process it is sought to be made clear that the patentee has the exclusive right to the sale in India of articles made by the patented process. Such a provision would be of advantage to Indian patentees.

Clause 48 is intended to clarify the rights of research workers and the like to use the invention in the course of research as distinguished from use for commercial purposes. It also seeks to provide that import of medicines or drugs or medical equipment by Government for its own purpose or the production of a patented article by Government for its own use shall not be regarded as an infringement of patent rights.

Clause 49 replaces section 42 of the existing Act and at the same time seeks to ensure reciprocity.

Clause 50.—This clause which is in modification of section 37 of the existing Act, seeks to define the rights *inter se* of joint patentees and follows section 54 of the U.K. Patents Act, 1949. In addition to cases where a patent has been granted to two or more persons, this clause also covers cases where registered ownership in a patent has arisen by assignment or devolution.

Clause 51 modelled on section 55 of the U.K. Patents Act, 1949, seeks to authorise the Controller to give directions to co-owners with respect to the exercise of their rights wherever necessary.

Clause 52 seeks to replace section 13(2) of the existing Act and provides for cases where patents have to be revoked in favour of the true and first inventor.

Clause 53 seeks to replace section 14 of the existing Act with suitable modifications. The term of every patent hereafter would be 14 years and not 16 years as hithertofore; but in the case of patents in the field of baby and invalid foods, medicines and drugs, where the process alone will hereafter be patentable, the term will be 10 years. The term of existing patents in this field would be limited to 10 years from the date of the patent.

Clauses 54, 55 *and* 56.—Modelled on section 26 of the U.K. Patents Act, 1949, these clauses considerably modify section 15A of the existing Act dealing with the grant of patents of addition in respect of improvements and modifications.

Clauses 57 *to* 59 deal with amendments of complete specifications before the Controller and before the High Court and correspond to sections 29 to 31 of the U.K. Patents Act, 1949. The scope of permissible amendments before and after acceptance of a complete specification is dealt with in clause 59. It is sought to be made clear that the scope of permissible amendments after acceptance of the complete specification cannot be wider or larger than that of an unamended specification.

Clauses 60 *to* 62 replace section 16 of the existing Act and seek to deal more elaborately with restoration in certain circumstances of lapsed patents and the procedure to be followed and the conditions which may be imposed in connection with such restorations.

Clause 63 deals with voluntary surrender of patents. It is now provided that in addition to the offer of surrender being advertised all persons interested in the patent should be notified and their opposition, if any, considered before the surrender is accepted.

Clause 64 deals with revocation of patents and replaces section 26 of the existing Act. It is now proposed that proceedings for revocation should lie only in the High Court. The grounds for revocation are now amplified in the light of experience gained and prevailing conditions. Under this clause it would be open to any person interested and also to the Central Government to apply for revocation.

Clause 65 is new and seeks to empower the Controller to revoke a patent or to have the complete specification amended where the invention relates to atomic energy.

Clause 66.—This reproduces section 25 of the existing Act with suitable safeguards and is a useful provision for the furtherance of the country's national economy.

Clause 67 seeks to provide for the maintenance of a patent register and the particulars to be entered therein.

Clause 68 seeks to provide that every transaction relating to patents which is registrable should be entered in the register as soon as possible after the transaction is entered into. At present while patent registers furnish complete information as regards proprietary interests, the same cannot be said of licences and other interests.

Clauses 69 *and* 70 deal with the registration of proprietary interests in patents and the power of registered grantees or proprietors to deal with such patents.

Clause 71 seeks to provide for the rectification of registers by the High Court.

Clause 72 seeks to declare that the register shall be open to public inspection.

Clauses 73 *to* 76 deal with the establishment of a patent office. Clause 75 which is new seeks to disqualify employees of the patent office from acquiring any interest in patents except by way of inheri-

tance or bequest. Clause 76, which is also new, requires the employees of the patent office (upon pain of punishment) to observe secrecy in respect of confidential information and documents to which they may have access in the discharge of their duties.

Clauses 77 to 81 deal with the general powers of the Controller and their exercise. The powers include a power to correct clerical errors in patents or in specifications or in other documents or in the register.

Clause 82 contains certain special definitions. For the purposes of Chapter XVI it has to be made clear that a patentee includes an exclusive licensee who has the sole right to grant a sub-licence.

Clause 83 seeks to emphasize as does clause 94 from another aspect that the main purpose for which a patent is granted is to have the invention worked in this country to its advantage.

Clauses 84 *and* 85 deal with the grant of compulsory licences where a complaint is made that the patent has not been worked in such a manner as to satisfy the reasonable requirements of the public, and are in amplification of the provisions contained in section 22 of the existing Act.

Clause 86 replaces sections 23A and 23B of the existing Act. As in the existing Act, the right to apply for endorsement of patents with the words "Licences of right" is confined to the Central Government as "persons interested" in working the invention might not desire that other persons besides themselves should also have the right to obtain licences.

Clause 87 is new and provides that patents in the field of drugs, medicines or baby and invalid foods and chemical inventions shall be deemed to be endorsed with the words "Licences of right". The royalty payable under any compulsory licence, if granted hereafter in respect of such substances other than chemical processes is sought to be regulated by clause 88. Suitable provisions are also being made to enable an applicant for a licence to work the invention pending determination of the royalty. These provisions are intended to secure the proper development of the food, drug and chemical industries in the country.

Clause 89 seeks to vest a residuary power in the Controller to revoke a patent in the event of the invention not being worked to an adequate extent in the country, notwithstanding the compulsory licensing provision, etc. Such a provision will also have the indirect effect of inducing patentees to impart to licensees sufficient details as to the know-how for working inventions.

Clause 90 seeks to define what is meant by the expression "reasonable requirements of the public have not been satisfied" for the purposes of the preceding clauses in the context of an under-developed country like India.

Clause 91 seeks to empower the Controller to adjourn any proceeding under this Chapter for a period not exceeding 12 months so as to cover cases where it is sought to be shown that the time between the sealing of a patent and the application under this Chapter is not sufficient to enable the patentee to work the invention to an adequate extent.

Clauses 92 *and* 93 deal with the procedure to be followed and the powers of the Controller in relation to the grant of compulsory licences.

Clause 94 seeks to formulate certain general principles for the guidance of the Controller in granting compulsory licences.

Clause 95 seeks to regulate the terms and conditions which may be imposed in respect of compulsory licences. Except where the Central Government has otherwise directed, the import of a patented article cannot be permitted under the guise of a compulsory licence.

Clause 96 is intended to prevent the abuse of patent monopolies for blocking purposes and to facilitate the working of related patents.

Clause 97 seeks to replace sub-section (4) of section 23CC of the existing Act.

Clause 99.—For governmental purposes, the use of a patent by a Government undertaking is really equivalent to governmental use. In addition, the powers sought to be conferred by this Chapter may have to be invoked in relation to certain classes of undertakings in the private sector which may be notified for this purpose by the Central Government. The expression use of invention for the purposes of Government is being suitably defined to cover all such cases.

Clauses 100 *and* 101 seek to regulate the use of inventions for the purposes of Government and the rights of third parties in relation thereto. The authority to authorise the use of any invention would be the Central Government, but the purposes for which an invention may be used would include the purposes of a State Government, Government undertaking, etc.

Clause 102 would be useful to enable the Central Government to acquire an invention in certain circumstances, as for example, where it would be economical to acquire the patent instead of obtaining compulsory licences in respect thereof.

Clause 103.—Jurisdiction is sought to be vested in the High Court to decide disputes relating to the use of any invention for the purposes of Government.

Clause 104.—While suits for declarations, infringements, etc. may be brought before the district court as under section 29 of the existing Act, jurisdiction to hear petitions for revocation of patents which will have effect beyond the parties to the proceedings is given only to the High Court under clause 64.

Clause 105 is patterned on section 66 of the U.K. Patents Act, 1949, and seeks to expressly authorise the court to grant declaratory decrees as to non-infringement even where the defendant has not denied the right of the plaintiff or has not asserted any adverse right in himself.

Clause 106 seeks to replace section 36 of the existing Act and provides for a remedy in case of groundless threat of legal proceedings.

Clause 107.—Based on section 32(4) of the U.K. Patents Act, 1949, this clause seeks to provide that the grounds on which a patent may be revoked would be available as grounds of defence to an action for infringement.

Clause 108 provides for reliefs which may be granted in a suit for infringement, the acts constituting infringement being determined with reference to clause 47 and the terms of the patent.

Clauses 109 *and* 110 deal with the rights of exclusive licensees and licensees under section 84 to take proceedings against infringement.

Clauses 111 *and* 112 seek to replace section 30 of the existing Act and restrict the power of the court to grant damages, injunction, etc., in certain cases.

Clause 113 seeks to replace section 32 of the existing Act, but the power to grant certificates of validity is confined to petitions for revocation. Where any such certificate has been granted, this clause seeks to regulate the costs in suits for infringement. Where a matter is taken to an appellate court by the patentee, the attack on the validity of the claim cannot be said to be frivolous and therefore sub-clause (3) does not vest any such power as to costs in the appellate court.

Clause 114 modelled on section 62 of the U.K. Patents Act, 1949, seeks to replace section 35A of the existing Act relating to infringement of partially valid specifications.

Clause 115.—Section 35 of the existing Act provides for the hearing of suits under that Act with the aid of assessors. This clause seeks to set out in more precise terms the type of persons to be appointed, their functions, remuneration, etc.

Clause 116 seeks to provide for appeals from orders of the Controller. In this connection, it is desirable to provide expressly that no appeal shall lie from decisions and orders of the Central Government on the lines of section 109(1) of the Trade and Merchandise Marks Act, 1958.

Clause 117 seeks to lay down the procedure for the hearing of appeals. It is in modification of the provisions contained in section 23G of the existing Act and follows section 109(4) and (5) of the Trade and Merchandise Marks Act, 1958.

Clauses 118 *to* 124 seek to provide for the punishment of offences under the new law. The existing Act does not contain adequate provisions in this behalf, the only penalty provided therein (section 78) being in respect of the wrongful use of the words "patent office".

Clauses 125 *to* 132.—The provisions contained in sections 75 and 76 of the existing Act on the subject of agency are insufficient to regulate appearances before the Controller by persons styling themselves as patent agents. It is desirable, as in other countries, that patent agents should be properly qualified to do their work—a work which involves great skill and responsibility. These clauses, which are new, therefore provide for statutory control of patent agents. No person whose name is not entered in the register of patent agents will hereafter be permitted to describe himself as a patent agent, but nothing in this Chapter would compel an individual to resort to a patent agent for filing his application or prevent him from acting in the matter himself or through an authorised agent.

Clauses 133 *to* 139 seek to replace section 78A of the existing Act which is confined to reciprocal arrangements between India and the United Kingdom and other parts of Her Britannic Majesty's dominions by more comprehensive provisions. Apart from making due provision for the mutual protection of inventions, a clause on the lines of section 132 of the Trade and Merchandise Marks Act, 1958, has also been included (clause 134) whereby nationals of countries which do not accord reciprocity to our citizens will be denied the right to apply for patents, etc., in India.

Clause 140 based on section 57 of the U.K. Patents Act, 1949, and section 112 of the Australian Patents Act, 1952, is new, and is intended to ensure that patent rights are not made an instrument of a monopoly wider in scope or longer in duration than afforded under

the patents by the statute. Accordingly, conditions in contracts, leases or licences which tend to impose restrictions on the other party with regard to the purchase of articles or use of processes other than the patented article or patented process are rendered void as being restrictions on trade injurious to the public interest. This clause will also apply to contracts made before the commencement of this new law in so far as any such restrictions are allowed to continue after the expiration of three months from such commencement. The period of three months would enable the parties to have the contracts suitably altered, if they so choose.

Clause 141 is also new and is designed to counter attempts by patentees to extend the duration of their patent monopolies beyond the period allowed by statute. This clause will enable the patentee, lessee or licensee to determine a contract containing any such restrictions on giving three months' notice.

Clauses 143 *and* 144.—These clauses while placing restrictions upon the publication of reports of examiners, specifications, etc., seek to vest a discretion in the Controller as to the publication of the result of any search under clause 13. Such a provision would be of value to inventors who desire to know the extent of a prior invention.

Clause 146.—This provision which is confined to information regarding the extent to which an invention is being commercially worked in India is necessary for the proper working of this law, apart from its statistical value.

Clause 147.—Sub-clauses (*1*) and (*2*) are based on sections 71 and 71A of the existing Act and sub-section (*3*) is based on section 116 of the Trade and Merchandise Marks Act, 1958.

Clause 151 seeks to replace section 33 of the existing Act by more elaborate provisions. While orders of High Courts regarding revocation of patents or certificates of validity of claims are to be entered in the register of patents, orders of other courts in suits for infringement, etc., are to be filed in a supplemental register as such orders affect only the parties thereto.

Clause 161.—This clause makes special provisions in respect of applications for patents which were referred from time to time to the Department of Atomic Energy for directions as they had references to atomic energy. These applications now stand lapsed, due to no fault of the applicants, on the ground that the maximum period of acceptance prescribed under sub-section (*4*) of section 5 of the Indian Patents and Designs Act, 1911, has expired.

FINANCIAL MEMORANDUM

The Bill seeks to amend and consolidate the law relating to patents contained in the Indian Patents and Designs Act, 1911, with a view to stimulate inventions among Indians and to encourage the development and exploitation of new inventions for industrial progress in India and to ensure that patent rights are not abused, to the detriment of the national interests. The Patent Office, which administers the Indian Patents and Designs Act, will have to keep a close watch over the commercial exploitation of patents and licensing and other proceedings under the Act. The steady increase in the number of applications for patents year after year, the proposal for extensive world-wide search for novelty, the expansion of the grounds of opposition, grounds for the grant of compulsory licences and the provisions for revocation for non-working, will involve additional functions on the Patent Office.

Clause 13 of the Bill envisages compulsory search for ascertaining 'novelty' of an invention and for determining 'anticipation', the scope of search extending to prior publication not only in India but elsewhere. Involving as it does much heavier work and responsibility than at present, it will necessitate an appreciable augmentation of the Examining and Supervisory officers of the Patent Office. Further, it will necessitate the setting up of a Special Abstracting Section at the Patent Office, Calcutta, which will engage itself on the collection of all *foreign* patent specifications and other technical documents, classification of the same industry-wise, preparing abstracts of the same and printing or duplication of the abstracts, etc.

Clause 74(2) of the Bill provides for the establishment of branch offices of the Patent Office at different centres in the country in order to meet the growing requirements of the public and to facilitate registration of patents. To begin with, it is intended to have 3 branch offices of the Patent Office at Bombay, Delhi and Madras. This is on lines similar to the three branch offices of the Trade Marks Registry functioning at Calcutta, Delhi and Madras under the Trade and Merchandise Marks Act, 1958. The branch offices will be concerned with receiving of applications for patents, preliminary examination of the applications and amendments there-

to, taking hearings and attending to all further correspondence such as communication of orders and the like, except of course detailed search for anticipation which will be conducted at the Head Office, Calcutta.

Clause 115 of the Bill envisages the appointment of Scientific Advisers to assist the Court in any suit for infringement or in any proceeding before a Court under the Act.

The aforesaid measures will involve extra work and will necessitate employment of some additional staff. The expenditure on account of additional staff, together with incidental expenses on administration is estimated at about Rs. 4 lakhs including Rs. 20,000 non-recurring. The actual recruitment of staff will, however, be made as may be determined by careful work-study.

Requirement of personnel and finance:

1. Annual emoluments of officers:—			
(*a*) Asstt. Controllers.	7	}	Rs. 2,57,000
(*b*) Examiners of Patents & Designs	27		
2. Annual emoluments of staff:—			
(*a*) Senior Scientific Assistants.	10	}	Rs. 98,700
(*b*) Asstt. Supdts.	3		
(*c*) U.D.Cs.	9		
3. Incidental expenses.			Rs. 44,300
		TOTAL:—	Rs. 4,00,000

Taking the average of the past 3 years, the annual expenditure of the Patent Office is of the order of Rs. 9·5 lakhs, while the annual income by way of fees realised amounts to Rs. 13·2 lakhs. It is to be mentioned in this context that while a general increase in the revenues may be expected on account of the filing of larger number of applications for patents year after year and also on account of the enhanced rates of fees for applications and for renewals, yet the reduction of the term of patents from 14 years to 10 years and the

stopping of the grant of product patents in the fields of food, drugs and medicine, will probably offset to some extent the above. However, on balance it may be expected that the present revenue is likely to be maintained. Apart from that, as so pertinently pointed out by Shri Justice Rajagopala Ayyangar in his report on the Revision of Patents Law "The maintenance of a Patent Office should be considered a service rendered to the public, and this is how it is looked upon the U.K. & U.S.A. and other advanced countries and therefore if an increase in the cost should result in an increase in the efficiency of the service, the cost is always worthwhile."

MEMORANDUM REGARDING DELEGATED LEGISLATION

Clause 158 authorises the High Court to make rules as to the conduct of procedure in respect of proceedings before it under this law.

Clause 159 authorises the Central Government to make rules for carrying out the purposes of this law. The rules are subject to the condition of previous publication. The matters set out in that clause in respect of which rules may be made are matters of a procedural nature and are merely ancillary to the proper implementation of this law.

The rule-making power sought to be conferred by the above two clauses is of a normal character.

S. L. SHAKDHER,

Secretary.

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